4

SUPREME COURT OF THE UNITED STATES.

No. 259.

D. P. HOLLOWAY, COMMISSIONER OF PATENTS, PLAINTIFF IN ERROR,

vs.

ANDREW WHITELEY.

IN ERROR TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

INDEX.

	Original.	Print.
Copy of writ of error	1	1
Copy of citation	2	1
Petition	4	1
Opinion of Commissioner of Patents	30	11
Judgment	46	22
Clerk's certificate	47	22

1 UNITED STATES OF AMERICA, *to wit:*

The President of the United States to the justices of the supreme court of the District of Columbia, greeting:

Because in the record and proceedings, as also in the rendition of a judgment in a plea, which is in the said supreme court before you, between Andrew Whiteley and D. P. Holloway, a manifest error hath happened, to the great damage of the said D. P. Holloway, as by his complaint appears, and it being fit that the error, if any there hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, you are hereby commanded, if judgment be therein given, that then, under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the first Monday of December next, in the said Supreme Court, to be then and there held, that the record and proceedings being inspected, the said Supreme Court may cause further to be done therein to correct that error what of right, and according to law and custom of the United States, should be done.

2 Witness the honorable Roger B. Taney, Chief Justice of the said Supreme Court of the United States, this sixteenth day of June, in the year of our Lord one thousand eight hundred and sixty-four, and of the independence of the United States the eighty-eighth.

R. J. MEIGS, *Clerk.*

UNITED STATES OF AMERICA, *ss:*

To Andrew Whiteley, greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, to be holden at Washington on the first Monday of December next, pursuant to a writ of error filed in the clerk's office of the supreme court of the District of Columbia, wherein D. P. Holloway is plaintiff and you are defendant in error, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected, and speedy justice should not be done to the parties in that behalf.

Witness the honorable David K. Cartter, chief justice of the supreme court of the District of Columbia, the 16th day of June, 1864.

D. K. CARTTER,
Chief Justice.

I acknowledge due and legal service of this citation, June 16, 1864.

JO. C. CLAYTON,
Attorney for Relator.

3 Proceedings before the supreme court of the District of Columbia, in general term, on the third Monday in January, in the year of our Lord one thousand eight hundred and sixty-four. Present, Chief Justice Cartter and Justices Fisher and Wylie; Justice Olin absent, holding the criminal court of the District of Columbia.

4 *Petition for writ of mandamus.*

To the honorable judges of the supreme court of the District of Columbia:

The petition of Andrew Whiteley, of Springfield, in the county of Clark, and State of Ohio, humbly showeth: That he made application on the 21st

day of May, 1863, to the Hon. Commissioner of Patents for the reissue of the reissued patent granted to Jonathan Haines, April 13th, 1858, and complied with all the requirements of the law; that his said application has been refused by said Commissioner, and that the following shows the substantial facts in relation to his case.

On the 4th day of September, 1855, Jonathan Haines, of Pekin, in the county of Tazewell, and State of Illinois, had granted to him letters patent of the United States for improvements in mowing machines. On the 22d day of November, 1856, said Haines sold, assigned, and set over to the firm of Ball, Aultman & Co. all his right, title, and interest in the invention as secured to him by said letters patent, for, to, and in the State of Ohio, and in no other place or places. Previous to April 13th, 1858, said
5 Haines surrendered his said letters patent to the Commissioner of Patents for correction and reissue, and without the consent of said Ball, Aultman & Co.; said surrender having been accepted by said Commissioner, new or reissued letters patent therefor were granted said Haines, which bear date April 13th, 1858. On the 15th day of January, 1860, said Haines sold and assigned to his brother, Ansel Haines, one undivided third interest in said patent. On the 25th day of January, 1860, said Jonathan and Ansel Haines sold, granted, and set over to Isaac A. and W. C. Hawley the right to make, sell, and use the "Haines Illinois mower," as patented to Jonathan Haines September 4th, 1855, and reissued April 13th, 1858, in certain counties in Illinois, (the north half of the State.) On the 10th day of April, 1863, said Ansel Haines reassigned to said Jonathan Haines all the rights in and to said patent purchased of him January 15th, 1860, except the rights granted to said Isaac C. and W. C. Hawley. On the 17th day of April, 1863, said Jonathan Haines sold, assigned, and delivered to your petitioner his aforesaid patent of April 13th, 1858, for the special purpose of enabling him to procure a reissue thereof, it being then understood that the main claim therein was too broad, and that it was in such shape that a disclaimer could not be made. Your petitioner has no knowledge that
6 Ball, Aultman & Co. ever elected to hold under the reissue procured by said Jonathan Haines April 15th, 1858, and is fully satisfied that they have never done so, as he had a written request presented to them inviting them to join him in procuring a reissue of the aforesaid reissued patent, and share the benefits thereby derived with him, which was returned without any answer thereto. Your petitioner, therefore, (believing himself possessed of the same rights which Haines possessed when he procured said reissued patent,) prepared his application (in three divisions) for the reissue of the aforesaid reissued patent granted to Jonathan Haines April 13th, 1858, and filed it with the chief clerk of the United States Patent Office (who was then acting Commissioner of Patents) on the 21st day of May, 1863, in conformity with section 13 of the act of 1836.

The 46th section of the rules of the Hon. D P. Holloway, Commissioner of Patents, published May 1st, 1862, and in use at the time when your petitioner filed his aforesaid reissue application, says: "Reissued patents expire at the same time that the original patent would have done. For this reason applications for reissue will be acted upon immediately after they are completed." Notwithstanding this rule, the first binding official action upon your petitioner's aforesaid application was made on the 16th, and
7 received on the 17th of February, 1864, nine months, lacking four days, after filing the same. Your petitioner being verbally informed (when in the Patent Office, on other, a few days after filing his aforesaid application) that it had not gone forward to the examiner for action on its merits, inquired of the acting Commissioner whether such was the fact, and was informed that it was, and that the reason it had not been

sent forward was that Ball, Aultman & Co. owned the exclusive right to the invention, as secured by said patent, in the State of Ohio. On examination of the records of the Patent Office at this time, it was found that the reassignment of said Ansel Haines to Jonathan Haines was not recorded; this was written for, received, and recorded, and thereby the assignment of the aforesaid patent from said Jonathan Haines to your petitioner was made complete.

On the first day of June, 1863, your petitioner handed said acting Commissioner a letter, the last paragraph of which reads as follows: "Now, may it please your honor, your petitioner requests to be informed, at your earliest convenience, (as time is very precious to him during the delay of an action upon his aforesaid application for the reissue of said patent,)

8 whether the aforesaid deed of assignment to him places him in possession of the right to reissue said patent; provided he who has the deciding of such questions should decide that the 13th section of the act of July 4th, 1836, or any other in force at the date of the filing of said reissue application, authorizes said reissue; provided said Ansel Haines should have reassigned to Jonathan Haines all his interest in said patent previous to the date of your petitioner's deed from Jonathan Haines, and said Ansel Haines's deed is recorded in your office; and if not, whether said right yet remains in said Jonathan Haines to procure a reissue of said patent; provided he had a reassignment from Ansel Haines for his interest in said patent, and said deed recorded in your office.

"Yours, respectfully, &c., &c.,

"A. WHITELEY."

Your petitioner thereupon employed Mr. Daniel Breed as his attorney in said case, who, after making a brief but clearly written showing of his case, convinced said acting Commissioner, for the time being, that the law was in our favor. But, to assure himself of the correctness of this course, he (informally) sent the question, "What are the rights of assignees, by law, who do not hold all the territory covered by the patent?" to the "appeal board" for their opinion. Said board, after a careful investigation of the question of your petitioner's right to procure the reissue in question, reported in his favor.

About this time the Hon. D P. Holloway, Commissioner of Patents,

9 returned to duty, and on examination of said board's opinion upon said question submitted to them, dissented from said opinion, but made a written request upon them for an opinion thereon. Thereupon said board revised their first report, and submitted the opinion requested on the 16th of June, 1863, which opinion is also in favor of your petitioner's right to procure the reissue asked for, as the last and following paragraph of said opinion shows: "After having given the subject a most careful consideration, we unhesitatingly express the opinion that Mr. Whiteley's right to surrender and apply for a reissue is clear and unmistakable. We, therefore, recommend that his present application be entertained and disposed of in the same manner as if made by the patentee himself in the absence of any transfer to Whiteley."

Your petitioner getting no answer to his letter of June 1st, 1863, neither any decision upon the question of his right to procure the reissue asked for from said Commissioner of Patents, up to the morning of June 30th, 1863, handed him a letter, of which the following is a copy:

Hon. D. P. HOLLOWAY, *Commissioner of Patents:*

SIR: You are hereby informed that I have received no answer from you to my letter of the first inst., in relation to my application for the re-

10 issue of the reissued patent of Jonathan Haines, granted April 13th, 1858, on his patent of September 4th, 1855. I fully expected your answer to said letter within 48 hours at farthest, as the subject to which it related and the peculiar standing of the case was fully sufficient to warrant such an expectation. I go to New York this evening, and greatly need your answer to said letter before going there. I therefore request that it be furnished me before your office is closed this afternoon, as it will be a great loss to me should I not get it. Dr. Breed will still remain in charge of the question of whether I can or cannot procure a reissue of said Haines's patent.

Very respectfully, yours,

(Signed) ANDREW WHITELEY.

Previous to July 23d, 1863, your petitioner prepared a written argument upon his right to the reissue asked for, and handed it to the Hon. D. P. Holloway, Commissioner of Patents, but has been unable to get a single scratch of a pen from him in relation to the aforesaid reissue application up to the 17th inst., when his attorney received the following:

U. S. PATENT OFFICE, *Feb'y* 16, 1864.

SIR: Your application for the reissue of letters patent for improvements in mowing machines, numbered 13,523, granted to Jonathan Haines Sept'r 4th, 1855, is refused, for reasons on file.

11 Respectfully,

(Signed) D. P. HOLLOWAY, *Comm'r.*

A. WHITELEY, Esq.,
Care of Dr. D. Breed, Washington, D. C.

On the 17th inst, your petitioner, by his attorney, addressed a letter, of which the following is a copy, to the Commissioner of Patents:

WASHINGTON, D C., *Feb'y* 17, 1864.

To the Hon. D. P. HOLLOWAY,
Commissioner of Patents:

By your decision of the 16th inst., it is understood that you regard J. Haines as the only party who can properly apply for a reissue of the patent granted to said J. Haines, April 13th, 1858. Before acting upon the case I respectfully request to be informed whether you regard said Haines as now possessing the right to reissue the patent independent of myself as assignee, or whether I must reassign to him before he could procure such reissue.

Respectfully,

A. WHITELEY,
Per D. BREED.

The Hon. D. P. Holloway, Commissioner of Patents, as Dr. Breed informs your petitioner, refused to answer this letter.

On the 19th inst. your petitioner offered the then acting chief clerk
12 of the United States Patent Office twenty-five dollars and the requisite papers for being allowed an appeal from this said decision of the Commissioner of Patents to the hon. judges of the supreme court of the District of Columbia, and requested that said appeal be allowed him, and that on the 20th inst. he tendered to said acting chief clerk, and was told that the peremptory order of said Commissioner of Patents forbid him to allow said appeal to be taken.

After this your petitioner handed said Commissioner a letter, of which the

following is a copy, and received the appended answer thereto from him verbally:

WASHINGTON, D. C., *Feb'y* 22, 1864.

To the Hon. D. P. HOLLOWAY,
Commissioner of Patents:

In view of the fact of your having often said to me, during the pendency of my application for the reissue of the reissued patent granted Jonathan Haines, April 13th, 1858, that your feeling was in favor of allowing me to procure the reissue of said patent asked for, provided the law authorized the grant of said reissue, will you not, therefore, consent that I may take an appeal to the supreme court of the District of Columbia from your decision in said case, made on the 16th inst., for the purpose of procuring a judicial construction upon the law governing such cases, so that it may be known what its true construction and meaning is.

13 Yours, respectfully,

(Signed) ANDREW WHITELEY.

This letter the said Commissioner handed back, with the remark that "he had nothing to do with that, as the law did not authorize it, and that he could not make a law."

This prayer to your honors for relief having been copied only this far before the following letter was received, it is inserted for judicial examination as to whether it is such an answer as will enable your petitioner to know what his future action must be in order to procure his reissue.

U. S. PATENT OFFICE, *February 22d*, 1864.

SIR: Your letter of Feb'y 17th, in relation to the rights of assignees to reissue a patent, has been received.

The assignee of a patent may surrender it and take a new patent, but the assignee of a part of a patent cannot. If the patentee have parted with all his right to the patent, nothing less than the reassignment of the whole patent to him can confer the right of surrender and reissue. The reassignment of a part of the patent to him, only an assignee in part, and possessed of no other rights than those to whom he originally assigned. If an assignee in part reassigns to the original patentee, he cannot confer

14 the right of surrender which he does not himself possess. The simple fact that he was originally the patentee does not revive his former powers under a reassignment of a fractional interest. He has no power beyond those of an assignee in part. If all the assignees in part should concur as one individual in a surrender, it could be done, but their mutual assent is necessary.

The original patentee may surrender, no matter how small an interest he may have retained, and the reissue affects his interest alone.

This is believed to be the law for this case, and has always been the ground of practice in the Patent Office.

Respectfully, yours,

(Signed) D. P. HOLLOWAY, *Comm'r.*

A. WHITELEY, Esq.,
Care of Doct'r Dan'l Breed, Washington, D. C.

C. Aultman & Co., the successors to Ball, Aultman & Co., who have the exclusive right to make, use and sell the invention secured by said Haines's patent of Sept. 4th, 1855, in Ohio, but in no other place, and their licensees have, as your petitioner believes, made and sold, since the reissue in question ought to have been granted, from five to fifteen thousand mowing ma-

chines outside of Ohio, which infringe upon the invention in question, and would have done upon the reissue applied for, if granted in accordance with the requirements of the law in relation thereto, while said parties have not sold more than from one-tenth to one-fifth the number of machines in Ohio—owned by them—than they have out of it, and where they have no right to sell said machines.

Another class of manufacturers, not properly to be regarded as the licensees of said C. Aultman & Co., but who have made a general exchange of licenses with them, have made and sold outside of Ohio since the reissue in question ought to have been granted, a much larger number of mowing machines which infringe upon the aforesaid invention belonging to your petitioner, and which would have infringed upon the reissue in question, had it been granted as it ought to have been.

These several manufacturers will, in all probability, nearly double this season the number of mowing machines made and sold by them last season.

Your petitioner has already paid a large sum of money for the aforesaid reissued patent granted said Haines April 13th, 1858; has expended much money and time in endeavoring to procure his aforesaid reissue; has large payments falling due to said Haines this season which he has no means of meeting, as he fully expected, when he bought said patent, to have obtained his reissue, and obtained means therefrom to make his payments with; and therefore must, so far as he can now see, suffer ruin, unless he can get the relief prayed for, as said Haines holds a mortgage on the patent, which he can close whenever payment is not punctually made.

From the foregoing your honors will see that your petitioner has done everything in his power to procure the reissue in question, before asking a writ of mandamus, and failed to do so, and also that he has suffered great by the errors of the Hon. Commissioner of Patents.

Your petitioner, therefore, prays that a writ of mandamus may be issued to the said Commissioner, commanding him to send your petitioner's aforesaid application for reissue forward to the examiner having charge of the class to which it belongs, to be acted upon by him in the same manner as though made by the patentee, in the absence of his having assigned his aforesaid patent to your petitioner, and before of the of , 1864; or that a rule on the said day of , 1864, may be granted, to show cause why a writ of mandamus should not be issued for the purposes aforesaid. And your petitioner will ever pray, &c.

ANDREW WHITELEY.

CITY AND COUNTY OF WASHINGTON,
District of Columbia, ss:

On the 25th day of February, 1864, personally appeared before the subscriber, a notary public in and for said city, the above-named Andrew Whiteley, who is known to him to be the person represented in the foregoing prayer for a writ of mandamus, and made solemn oath that foregoing statements are true, as he verily believes.

EDM. F. BROWN,
Notary Public.

{ Notary's seal. }

Endorsed: Filed 25th Feb'y, 1864.

SATURDAY, *February* 27, 1864.

ANDREW WHITELEY, relator,
v.
D. P. HOLLOWAY, respondent. } No. 856.—Petition for mandamus.

On reading and filing the relator's petition, supported by his affidavit, it

is ordered by the court, that the Hon. D. P. Holloway, Commissioner of Patents, appear before this court on Saturday, the 5th day of March, 1864, at ten o'clock a. m., to show cause why a mandamus should not be issued, commanding him to send the application of the relator, in his petition described, to the examiner having charge of the class to which it belongs, to be acted upon by him.

18 SATURDAY, *March* 5, 1864.

ANDREW WHITELEY, relator,
v.
D. P. HOLLOWAY, Commissioner of Patents. } No. 856.—Petition for mandamus.

Come as well the relator, by his solicitor, Mr. Breed, as the respondent, by his solicitor, Mr. Hayes; and thereupon, after argument of the rule aforesaid, and mature deliberation thereon, it is considered by the court that said rule be made absolute, and that a writ of mandamus be issued from this court, commanding the respondent to send the application of the relator, in his petition and affidavit described, to the examiner having charge of the class of subjects to which said application belongs, to be acted upon by him according to law.

In the supreme court of the District of Columbia, March 7, 1864.

ANDREW WHITELEY, relator,
v.
D. P. HOLLOWAY, Commissioner of Patents, respondent. } No. 856.—At law.

The President of the United States to the respondent, greeting:

Whereas the relator, Andrew Whiteley, has made it appear to said court that he is the assignee of a patent reissued to Jonathan Haines, on
19 the 13th of April, 1858, for improvements on mowing machines; that being such assignee, he filed in your office on the 21st of May, 1863, an application for a reissue of the said patent, and that you have refused to examine said application, or to cause the same to be done, to the great damage and grievance of the said Andrew Whiteley, as by his complaint to said court is made to appear:

To the end, therefore, that speedy justice may be done to said Andrew, in this behalf, as is reasonable, you are hereby commanded to examine said application, or cause the same to be examined, according to law, or signify to said court the cause to the contrary thereof. And how you have executed this writ certify to said court, without delay.

Witness David K. Cartter, chief justice of said court.

R. J. MEIGS, *Clerk*.

Endorsed: Writ of mandamus, issued March 7, 1864, returnable immediately.

Service acknowledged.

D. P. HOLLOWAY, *Com.*

Served the within writ on D. P. Holloway, esq., this 7th of March, 1864. See acknowledgment of service.

W. H. LAMON,
U. S. Marshal, D. C.

20 Proceedings before the supreme court of the District of Columbia, holding a general term, commencing on the first Monday of May, 1864. Present and presiding, Chief Justice Carlton, and Justices Olin and Wylie; absent, Justice Fisher, holding the criminal court.

SATURDAY, *May* 24, 1864.

ANDREW WHITELEY
v.
D. P. HOLLOWAY. } No. 856.—Mandamus.

The relator, Andrew Whiteley, by his attorney, Jo. C. Clayton, moves the court for a peremptory mandamus upon the respondent, in the terms of the alternative writ, granted March 7, 1864, and files his motion in writing, supported by his affidavit. Whereupon the court orders that a copy of said motion be served upon the respondent, by the marshal, and that said motion be heard on Saturday, the 28th instant.

In the supreme court of the District of Columbia, the 21st of May, 1864.

ANDREW WHITELEY, relator,
v.
D. P. HOLLOWAY, respondent. } No. 856.—Mandamus.

The President of the United States, to the marshal for the District of Columbia, greeting:

21 The relator, in the above-entitled cause, having filed his motion in writing, in the following words: "The relator hereby moves for a peremptory writ of mandamus upon the said respondent, in the terms of the alternative writ, granted March 7, 1864. Jo. C. Clayton, att'y for relator. 21st of May, 1864;" and the court having ordered that the respondent be served with a copy of said motion, to the end that he may attend the hearing thereof, which is fixed for the 28th of May, inst.:

You are, therefore, hereby commanded to serve the respondent with a copy of said motion; and having so done, do you make return, upon this precept, how you have executed it, together with the date of your said execution of it.

Witness David K. Cartter, chief justice.

R. J. MEIGS, *Clk.*

Endorsed: Issued May 21, 1864; returnable May 28, 1864. Copy of this writ served upon the respondent in person, May 23, 1864.

WARD H. LAMON,
U. S. Marshal, D. C.

In the supreme court of the District of Columbia, May 28, 1864.

A. WHITELEY, relator,
v.
22 D. P. HOLLOWAY, Com'r of Patents. } No. 856.—At law.

The respondent, D. P. Holloway, moves your honorable court for an extension of time for twenty days, that he may show cause why a peremptory writ of mandamus should not issue in said cause.

D. P. HOLLOWAY, *Com'r.*

I, David P. Holloway, respondent in the cause A. Whiteley, relator, against D. P. Holloway, Com'r of Patents, wherein the relator has moved for a peremptory mandamus upon the respondent, and wherein the respondent has moved an extension of time of twenty days, for the purpose of showing cause why said writ of mandamus should not issue, according to the terms of said writ, do hereby certify and say, that it is the intention of the respondent to show cause to the honorable supreme court of the District of Columbia why said peremptory writ of mandamus should not issue; that

the question involved in the issue presented in the granting of such a writ is deemed by the respondent to be of paramount interest to the U. S. Patent Office, to the public, and the relations subsisting between the honorable court and the U S. Patent Office; that the action of the respondent in this case has no personal connection whatever with the relator in this suit, but is had
23 solely in view of the duty of the Commissioner as a public functionary; that he deems it his duty to present the question involved formally and deliberately before the hon. supreme court; that since the issuing of the writ of mandamus, cases have arisen in the Patent Office involving analogous questions; that the consideration of these questions has involved much investigation, which the respondent believes will throw light upon the questions; and that the constant occupation of the respondent, and those under his command, to whom, necessarily, the proper preparation of the case for the consideration of the court must be intrusted, demands a further time of twenty days from the 28th inst., at the expiration of which time the respondent proposes to submit his views of the case, upon printed statements and arguments.

D. P. HOLLOWAY, *Com'r.*

WASHINGTON CITY, D. C.,
Co. of Washington, ss:

Personally appeared before me the above named D. P. Holloway, and made oath that the statements contained in the above affidavit are, to the best of his belief, true, this 28th day of May, 1864.

EDM'D F. BROWN,
United States Commissioner.

24 Endorsed: Filed May 28, 1864.

SATURDAY, *May* 28, 1864.

ANDREW WHITELEY
v.
D. P. HOLLOWAY. } No. 856.—Mandamus.

On motion of respondent by his attorney, Mr. Hayes, supported by respondent's affidavit, the hearing of the relator's application for a peremptory mandamus is postponed till Saturday, June 4, 1864.

Supreme court of the District of Columbia.

ANDREW WHITELEY, relator,
v.
D. P. HOLLOWAY, Commissioner of Patents. } No. 856.—At law.

To the honorable the judges of the supreme court of the District of Columbia:

The undersigned, David P. Holloway, Commissioner of Patents, respectfully states, that he hath been served with notice of a rule from your honorable court, requiring him to show cause why a peremptory writ of mandamus should not issue from said court, directed to him as Commissioner of Patents, upon the petition of Andrew Whiteley, relator, commanding him to examine or cause to be examined a certain application of the said Andrew
25 Whiteley, asserting himself to be the assignee of one Jonathan Haines, for a reissue of a patent for improvements in mowing machines.

Before proceeding to show cause why said writ of mandamus should not issue, the undersigned deems it his duty to reply to the imputation intimated in certain allegations contained in the petition of said Whiteley, that the undersigned had subjected the relator to unreasonable delay in considering his proposed application.

The undersigned avers, that there has been no more delay in the consider-

ation of said application than was incident to the proper investigation of the important questions presented, and to the constant occupation of the undersigned and those under his direction, with the current business of the Patent Office.

The undersigned further represents that, upon the presentation of said application, and on examination as to its tenor, it was found that, according to the interpretation of the law, which had been immemorially given by the office, the application could not be legally received and filed for examination, for the reason that the proposed applicant was not such an assignee
26 as the law contemplates. The application, therefore, was not filed, or entered upon the books of the office, and never has been. Neither were the fees required on such an application, to wit, ninety dollars in amount, which had been paid by the relator to the chief clerk of the office, on the presentation of said application, placed to the credit of the patent fund, nor have they since been but they remain in the hands of the chief clerk or his depository, personally, and subject to the order of the relator.

The undersigned further represents that, in order that no injury should accrue to the relator from error, in refusing to receive his application at the request of the relator, he submitted the question of the legality of receiving said application to the examiners in chief of the Patent Office, not for their decision, but for such light as their investigation might throw upon it. The views presented by th eexaminers in chief failed to convince the undersigned that the application could be lawfully entertained. He was, therefore, fully authorized at that time to peremptorily refuse the application. But, at the earnest request of the relator, he consented to waive a final decision, and to submit the question to the Attorney General of the United States, agreeing to decide the question in conformity with his opinion. Ac-
27 cordingly, on the —— day of ———, 1863, the undersigned, through the Secretary of the Interior, submitted the question as to the reception of said application to the Attorney General, for his opinion thereon. For reasons not officially communicated to the undersigned, no opinion was given by the Attorney General, and the papers submitted were not returned to the office until early in February. On the 16th of February the undersigned communicated to the relator his final decision to refuse to receive his application.

The undersigned has made the foregoing statement for the purpose of showing to your honorable court that the relator cannot rightfully complain of any wrong, delay or failure of due consideration on the part of the undersigned; but that, on the contrary, the undersigned has not exercised his judgment, in expounding the law under which he was required to act, without careful deliberation, and without invoking the aid of all the legal light and learning which he deemed himself authorized by law to command.

The undersigned now respectfully shows cause to your honorable court why said peremptory writ of mandamus should not issue.

28 First. That it is not in the power of the supreme court of the District of Columbia to command the performance of any duty incumbent upon any executive officer of the government, which is within the sphere of his ordinary executive functions.

Second. That the object sought in the writ of mandamus prayed for is indirectly to carry a preliminary question, solely cognizable by the Commissioner of Patents, by appeal, to the supreme court of the District of Columbia; and as the Commissioner will be bound by law not to admit such an appeal, the mandamus, would be nugatory and ineffectual.

Third. That the order contained in the writ, to examine or cause to be examined the said application, cannot be obeyed, because no application has been filed in the Patent Office.

Fourth. That the Commissioner has exercised all the action which can be lawfully required of him, in deliberately considering and determining upon the propriety of receiving said application.

29 Fifth. That the Commissioner rightfully rejected the application of the relator, in deciding that he was not such an assignee as is contemplated by the 13th section of the act of 1836, which gives an inventor the right of surrender and reissue, and in case of his death, or any assignment by him made of the original patent, vests a similar right in his executors, administrators, or assigns.

In support of the last course, the undersigned submits the accompanying copy of an opinion, which he prays may be received as a part of his answer.

All of which is respectfully submitted.

D. P. HOLLOWAY, *Com'r.*

Endorsed: Filed June 4, 1864.

Commissioner's opinion, (submitted as part of his return.)

30 Opinion of the Commissioner of Patents in the matter of the application of Andrew Whiteley, for reissue of letters patent.

31 UNITED STATES PATENT OFFICE,
August 10, 1863.

Andrew Whiteley has applied for a reissue of letters patent under the following circumstances:

The original patent sought to be reissued was granted to Jonathan Haines, of Tazewell county, Illinois, September 4, 1855, for improvements in mowing machines, and was numbered 13523.

On the 22d of November, 1856, the patentee sold and assigned and granted to Ball, Aultman & Co. an exclusive right to the invention and patent within the limits of the State of Ohio.

On the 13th of April, 1858, upon the surrender of the said original patent by Haines, and upon his application, without the consent, as it appears, of Ball, Aultman & Co, the grantees aforesaid, a reissue of the patent was granted, being numbered reissue 545.

On the 15th of January, 1860, Jonathan Haines sold and assigned to his brother, Ansel Haines, one undivided third part of his interest in the patent.

On the 25th of January, 1860, the said Jonathan and Ansel Haines sold and granted to Isaac A. and William C. Hawley the exclusive right to the invention and patent in certain counties in Illinois, (the north half of the State.)

On the 10th of April, 1863, Ansel Haines reassigned to Jonathan all his interest in the patent, thus reinvesting in the original patentee the entire interest in the patent, except the territorial rights sold as aforesaid to Ball, Aultman & Co., for the State of Ohio, and to Isaac A. and William C. Hawley for northern Illinois.

On the 17th of April, 1863, Jonathan Haines sold and assigned all his interest in the invention and patent (excepting the territorial rights previously disposed of as aforesaid) to Andrew Whiteley, the present applicant for a reissue.

Before filing the present application, the said Ball & Aultman (as the applicant alleges) were requested to join in the application for reissue, and share the benefits to be derived therefrom, but refused so to do, thereby electing to hold under the present reissue.

Whether the said Isaac A. and William C. Hawley acquiesce in this application for reissue or not, does not appear.

The question presented is, whether the grantee of an exclusive sectional

interest in a patent has the right of surrender and reissue given by the thirteenth section of the act of 1836 to the patentee of an invention, and in case of his death, or any assignment by him made of the original
32 patent, to his executors, administrators, or assigns. It has been the uniform practice of this office, under its construction of the thirteenth section of the act of 1836, to refuse a reissue to any grantee under a patent owning a less interest than the entire interest of the patentee, while it has also been the practice of the office to grant a reissue to the original patentee, notwithstanding he had granted exclusive sectional interests under the patent.

The principal difficulty in this question arises from the practice of the office last referred to, and from the decisions of the courts, in their attempts to reconcile this practice of the office with the interests of the grantees of exclusive sectional interests of patents. It is urged with much plausibility, "if the patentee, after having granted an exclusive territorial right, may surrender the patent, and obtain a reissue without the consent of the assignee or grantee of such territorial right, and without affecting the rights of such territorial grantee within his specified territory, there can be no good reason why he should not have the power to transfer the same privilege to another."

In the case before the office, Haines, the patentee, after having granted an exclusive territorial right, obtained a reissue of the original patent. Whiteley is the grantee from Haines of all the rights, with the exception, perhaps, of such rights of reissue as may have been given by the statute exclusively to the original patentee, which Haines possessed at the time of the reissue. It is difficult to perceive any reason in principle or equity, or in the manifest spirit of the statute, why the patentee and grantee, having the same limited territorial interests, should not have similar rights of surrender and reissue.

The question then arises, whether the practice of the office in allowing a patentee, who had granted exclusive territorial interests under his patent to make a surrender and reissue of his patent, without consent of such grantees, if the question like the one directly before the office were disembarrassed by judicial decisions, would be sanctioned by the spirit of the statute, and the general policy of the patent laws?

It is true that the statute, while giving the right of surrender and reissue to the patentee, makes no exception, in case he has granted away a portion of his interest; hence the practice of the office may have been justified by the strict letter of the statute. But it cannot be conceived that the legislature intended to give to the patentee, who had parted with all but a mere fractional interest in the patent, the right to surrender, and thereby affect the interests of innocent parties derived from himself. This doctrine was held by Mr. Justice Story in the first case reported, where the question of right of the patentee to surrender, under the statute of 1836, arose. He says: "I agree that it is not in the power of the patentee, by a surrender of his patent, to affect the rights of third persons to whom he has previously, by assignment, passed his interest in the whole or part of the patent without the consent of such assignees. (Woodworth *vs.* Stone, p. 750, 3 Story Reports.) It is true that it has been held by Judge Ingersoll, in the case of Potter *et al.* *vs.* Holland, Conn., 1858, that it is to be inferred that when Mr. Justice Story decided that it was not in the power of the patentee, by a surrender
33 of his patent, to affect the rights of third persons to whom he had previously passed his interest, either in whole or in part, without their consent, he must have been of the opinion that, notwithstanding such surrender and reissue, such third persons could hold under the old patent if they should so choose. This inference is derived solely from the circum-

stance that, "when the case of Woodworth *et al. vs.* Stone was before Judge Story, he knew that there were other persons in various parts of the United States who had rights under the original patent who had not joined in the surrender, and whose rights would be affected by the surrender against them if they should not agree to it, provided that he held the surrender good, and provided they could not hold under the old patent."

The opinion stated by Judge Ingersoll, to be inferred, seems to my mind to have been carefully waived by Judge Story.

The question was not raised in that case, for he says: "But here the supplemental bill admits that the assignees, &c., have consented to such surrender, and it becomes theirs in the same manner as if it had been their personal act." There is no intimation of the mode by which the rights of third parties might be protected after a surrender. It would, in my opinion, be a sounder inference from the copiousness of expression, which characterizes the judicial opinions of this eminent judge, that he would not have withheld the utterance of an opinion distinctly formed upon a material point in issue.

The leading case, which seems to sanction the doctrine that there is no valid objection to a surrender and reissue where the grantee of an exclusive territorial interest has not consented, is that of Potter *et al. vs.* Holland, (Com., 1858.) In this case an elaborate opinion is given by Judge Ingersoll.

After asserting it as a sound and settled principle that a person to whom the patentee has passed his interest in a part of the old patent, upon a surrender of the same by the patentee, and obtaining a reissued patent, is entitled to the same right under the reissued patent that he had under the old one, he says: "It does not follow from this, however, that because a person to whom a patentee has passed his interest in a part of a patent is entitled to the same right to a reissued patent that he had to an old one, that he is compelled to take under the reissued one, and thereby compelled to give up the right which he had under the old one. If he was, his right might be injuriously affected without his consent." The judge in terms affirms, that after a surrender and reissue, both the surrender and reissue being valid, a third person to whom a patentee had previously passed his interest "has the same rights under the old patent, if he chooses not to take advantage of the surrender and the reissue, that he had to that patent before such surrender and reissue." Without attempting to follow the somewhat obscure and inconclusive reasoning by which this proposition is maintained, it is sufficient to reply that this proposition implies the legal existence of two patents to different persons for the same invention, while the statute from which the power to grant is derived distinctly contemplates the existence
34 of but one patent for the same invention, and as distinctly demands the surrender of the old patent. If the surrender of the old patent has the effect to extinguish it, there is nothing in existence in which the third party can possess rights, except the reissued patent. The Supreme Court of the United States, at the December term, 1861, subsequently to decision in Potter *et al. vs.* Holland, have settled this question with great distinctness. Mr. Justice Nelson, in giving the charge of the court, says: "A surrender of the patent to the Commissioner within the sense of the provision (of the statute of 1836) means an act which, in the judgment of law, extinguishes the patent. It is a legal cancellation of it, and hence can no more be the foundation of a right after a surrender than could an act of Congress which has been repealed." This construction is in conformity with that adopted by the office, as shown in the recital of the surrender invariably contained in the reissued patent, which is as follows: "Whereas A. B. has alleged that he has invented a new and useful improvement in

, for which letters patent were issued to said A. B., dated (blank,) which letters having been surrendered by the said A. B., the same have been cancelled, and new letters ordered to issue to him on an amended specification"

It can hardly be denied that the effect of this decision is to overrule the authorities of inferior tribunals which may have held that rights could be asserted under surrendered patents.

It may be remarked with regard to these decisions sustaining the validity of the reissue of patents without the consent of third parties having exclusive territorial rights, that they were without doubt influenced by the desire to sustain the validity of rights obtained in good faith, and secured by the act of public officers, viz., the Commissioner of Patents, made under a conscientious interpretation of law. Judge Story does not hesitate to admit that, in a doubtful construction, he would give validity to an existing patent "*at res majis valeat quam pereat*," and the courts may not have hesitated to resort to the legal fiction of the *quasi* existence of a surrendered, and therefore cancelled, patent, upon the ancient ground of justification for fictions in law, that they may be resorted to to prevent a mischief, or remedy an inconvenience that might result from a general rule of law. (Blackstone's Com., vol. III, page 43.) But there is another rule of law in regard to those legal casuistries, viz.: that there is no reason for doing that indirectly which may be done directly. It is a different question when it comes originally before the Commissioner of Patents to establish a rule of practice which shall be consistent with a sound interpretation of the statute, public expendiency, and the general policy of the patent laws.

As an administrative officer, it is his duty to consider not simply whether he may be simply justified in continuing a former practice of the office by judicial decisions, but to determine whether such practice is consistent with public policy as well as a reasonable interpretation of the statute. It must be held a sound law, as asserted by Judge Story in Woodworth *vs.* Stone, and frequently reaffirmed by other authorities, that "it is not in the power of the patentee by a surrender of his patent to affect the rights of third parties to whom he has previously, by assignment, passed his interest in the whole or part of the patent without the consent of such assignees."

It is shown that such a surrender and reissue would affect the rights of third parties not consenting, unless such third persons may be held to hold under the surrendered patent. The highest tribunal in the land has held that the surrender "extinguishes" the old patent, and, consequently, with it all the rights of third parties under it. The third party could hold under the surrendered patent only by the purest legal fiction, which is against the policy of the law, if the inconveniences which result from a general law may be remedied directly. It follows, then, that it is not in the power of the patentee to surrender, or, what is the same thing, within the intent of the law, that he should surrender, in any event, without the consent of his assignees, in whole or in part. If the rule of practice should be adopted by the Commissioner of Patents that all applications for reissue should be refused without the consent of all parties to whom the patentee has assigned or granted his interest in whole or in part, the evident inconveniences resulting from the late practice would be directly remedied so far as future cases are concerned, and I cannot doubt that such practice would be conformable to public expediency and a sound construction of the law, or that such a rule would have been originally adopted if the inconveniences of the other rule had been foreseen.

If the views above presented are correct, the direct question whether the grantee of every exclusive sectional interest under a patent has the right of

surrender and reissue, is, as already intimated, freed from much embarrassment.

The clause in the statute from which the right of reissue is derived is in the 13th section of the act of 1836, and is as follows:

"Whenever any patent which has been heretofore granted shall be inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees." It is not pretended that assignees have any rights of reissue, except such as are derived from the above-quoted words of the statute. There is no ambiguity in the words of the statute, and in seeking for this meaning we must apply the first maxim of Vattel in the interpretation of treaties, which equally applies to statutes:

"That it is not allowed to interpret what has no need of interpreta-
36 tion. When a deed is worded in clear and precise terms—when its meaning is evident, and leads to no absurd conclusion—there can be no reason for refusing to admit the meaning which such deed naturally presents." The statute does not give the right of reissue in general terms to assignees, but it specifies the event in which they shall have that right, and designates the character of the assignees who shall have this right, viz: such as are made assignees by the assignment of the original patent. The language of the statute would have the same and no more limited effect if it had read, "in case of the assignment by the patentee of the original patent, the right (of reissue) shall vest in such assignee or assignees as shall have been created by such assignment of the original patent." Admitting that the words assignees and grantees, as used in the statute, are convertible terms, and that the patent laws recognize assignments, both of the whole and sectional interests, the assignee of a sectional interest is clearly excluded from the right of reissue, for an assignment of a sectional interest under a patent cannot by the most forced construction be held to be an assignment of the original patent, and it is to the assignee of the original patent that the statute in terms extends the right of reissue.

Although we admit, with Judge Story, "that there is no magic in words, but we must admit them as they stand and are used in the particular instrument." (Washburn *et al. vs.* Gould, 3 Story.) Yet when the framing of the statute shows that it has been artificially drawn, that its terms are not used indiscriminately in a broad and general sense, or as in common parlance, we should give to those words not only their precise effect as indicated in the careful selection of terms, but their legal intendment. This is eminently true of the statute of 1836, upon which the whole structure of our patent law may be said to rest, and which appears not only from the light of intrinsic evidence illuminating all its pages, but from cotemporaneous history, to have been prepared with a legal precision, as well as profound intelligence, which have secured its admitted position as one of the most important acts in our legislative history.

Whenever the term assignment is used throughout the statute of 1836, it is qualified or explained by some adjunct limiting its purport to the transfer or conveyance of the whole interest, or any undivided part thereof of the

original patent. Thus the 11th section, which precedes the one under discussion, defining how a patent shall be assignable, says: "Every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by any instrument in writing." It is thus made assignable only as a whole or for an undivided part; and it continues: "which assignment," viz., of the whole or any undivided part, "shall, and also every grant and conveyance of the exclusive right under any patent to make and use, and a grant to others to make and use the thing patented, within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the Commissioner the
37 sum of three dollars." The law does not of itself strike out words which the statute has carefully introduced. It construes an instrument so as to give a reasonable effect to all the words; as Lord Bacon has expressed the rule, *verba aliquid operari debent, verba cum effectu sunt accipienda.*

That all the words in these clauses should have operation, and that each should have its effect, it must be held that the statute distinguishes a grantee of an exclusive right from an assignee, for it cannot be conceived how that distinction can be expressed in clearer terms; and that when the term assignee is used in the statute, it intends the holder, by an instrument in writing, of the whole or any undivided interest in a patent.

This is precisely the legal and accurate intendment of assignment, independently of the construction derived from the statute, for the distinction between the terms assignment and grant, as used in the statute, is recognized by the sages of the profession, whose works have acquired, by time and intrinsic merit, the weight of authority.

Stephens, in his Commentaries on the Laws of England, (vol. 1, page 485,) says: "An assignment is properly a transfer or making over to another of one's whole interest, whatever that interest may be; but it is usually applied to express the transfer of an estate for life or years, and an assignment for life or years differs from a lease only in this: that by a lease one grants an interest less than his own, reserving to himself a reversion; in assignments he parts with the whole property, and the assignee consequently stands in the place of the assignor."

Burrill, in his Law Dictionary, refers to the above definition, italicising it as follows: "Mr. Stephens has otherwise modified the definition of Blackstone, making an assignment to be properly a transfer or making over to another of one's whole interest, whatever that interest may be," &c, &c.

The definition of Stephens is supported by older commentators. Mr. Thomas, in his notes on Coke on Littleton, vol. 2, p. 566, says: "An assignment is properly a transfer or making over to another of the whole interest or estate which the assignor has in lands or tenements, but it is usually applied to a transfer of a term of years. An assignment of a term differs from a lease only in this: that by an assignment the assignor parts with his whole interest and property in the thing assigned, and puts the assignee in his place." We find the following in Cruise's Digest, (vol. III, 160,) a work characterized by Kent as by far the most perfect elementary work of the kind which we have on the doctrine of real property: "An assignment is properly a transfer or making over of the interest or estate which the assignor has in lands and tenements. * * In an assignment, the assignor parts with his whole interest and property in the thing assigned, and puts the assignee in his place." * *

"The proper and technical words of an assignment are assign, transfer, and set over; but the words give, grant, bargain, and sell, or any other

words which show the intention of the parties to make a complete transfer, will amount to an assignment."

See, also, Shepherd's Touchstone, 268; Watkins on Conveyance, 1, 2, ch. IX.

39 The term grant is also used in the statute in its ancient and exact legal signification.

"This word is taken largely when anything is granted or passed from one to another." (Shepherd's Touchstone, 229.) "In a more strict and proper sense, it is a species of common-law conveyance appropriate to the transfer for whatever estate or hereditaments incorporeal, of which no livery or delivery can be made." (Burrill's Law Dictionary, vol. 1, p 693; 1 Stephens' Commentaries, 474.) Mr. Burrill says, "In the United States the term grant continues, in general, to be specifically applied to the conveyance of incorporeal hereditaments, and to letters patent from the government. It is hardly necessary to say that the exclusive right under a patent to make and use, and to grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States" is strictly an incorporeal hereditament, being an estate of which no livery can be made. The views entertained as to the distinction existing in the statute between assignees and grantees, are not only in conformity with the ancient meaning of the terms, but sustained by judicial interpretations of the statute. The opinion of eminent judges, and particularly those of the justices of the circuit and Supreme Courts of the United States, although mere *obiter dicta*, must be considered authoritative expositions of the law in the absence of direct decisions.

The most lucid opinion upon this point in question is given by Judge Ingersoll, in Potter *et al. vs.* Holland.

He says: "In the 13th section of the patent law of 1836, is contained all the right to make a surrender." * *

"The sole right to surrender is given (1) to the patentee, if he is alive, and has made no assignment of the original patent; (2) to the executors and administrators of the patentee after his decease, when there has been no such assignment; (3) to the assignee when there has been an assignment of the original patent, and the right to surrender is given to no one else. * * There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has transferred to him in writing the whole interest of the original patent, or any undivided part of such whole interest in every portion of the United States, and no one, unless he has such an interest transferred to him, is an assignee. A grantee is one who has transferred to him in writing the exclusive right, under the patent, to make, use, and to grant to others to make and use, the things patented within and throughout some specified part or portion of the United States. * * * The terms assignee and grantee are not used in the patent law of 1836 as synonymous terms, though courts, without having their attention particularly called to the subject, have sometimes used them indiscriminately and in their popular sense. They have, however, the separate and distinct meanings above indicated."

It may be said that I am estopped from relying upon the opinions of this judge, as the soundness of his decision upon another branch of this case is denied.

But the views above quoted have weight with me, not only from 40 the clearness of the statement and reasoning, but because they conform to the opinions of several of the judges of the Supreme Court of the United States.

Judge Story, although nowhere actually defining the meanings of assign-

ment and grant as used in the statute, apparently because in his apprehension there was no need of interpreting them, repeatedly uses language which leaves it beyond doubt that he recognized the distinction.

In the case of Washburn *et al. vs.* Gould, (3 Story, 165,) when he held that the parties contemplated that the patentee had parted with all his patent right within a certain territory, he deliberately denominates the instrument of conveyance a grant, using this expression: "The grant, for so I call it, was," &c.

In the case of Woodworth *vs.* Sherman, (3 Story, 171,) where the question arose as to the effect of the clause of the statute of 1836, extending to the "assignees and grantees" of the patent right the benefit of a renewal to the extent of their respective interests therein, Judge Story is careful never to confound the assignee with the grantee, as in the following passage: "Now, what is the extent of their (viz., the assignees and grantees) interest therein? Clearly, upon the principles of common law, neither more nor less than the assignor or the grantor then possessed, and was capable of assigning or granting at the time of the assignment or grant; for to that the language of the grant or assignment must in reason and good sense be limited, unless the grantor or assignor has by express words or necessary implication shown a broader intention—an intention not merely to grant or assign the right which he now possesses, but the possibilities which he may hereafter acquire; and these are the best grounds to support such a limitation and interpretation of the grant or assignment."

It is worthy of observation that where, in the same opinion, the same learned judge has occasion to speak of a transfer of the whole interest in the patent, he uses simply the term "assignment." Thus he says: Let us suppose a case where an assignment had been made by the inventor of his whole patent right under his patent for a small and, comparatively speaking, an utterly inadequate compensation, &c., &c.: could it for a moment be imagined that the 18th section intended, contrary to its professed object, to benefit, not the inventor himself, but his assignee?

The distinction between assignees and grantees, as referred to in the act 1836, is defined by Mr Justice Woodbury, in his dissenting opinion in the Supreme Court, in the case of Wilson *vs.* Rousseau, 4 Howard, where the question arose as to the effect of the clause in the statute of 1836, extending the benefit of renewal "to the assignees and grantees of the right to use the thing patented to the extent of their respective interests therein."

"The clause refers to two classes who may in such case be benefited by the renewal. 'Assignees' are one class, and 'grantees of the right to use the thing patented' are the other class.

41 "This accords with the language itself, and also with the punctuation of this clause, as examined by me in manuscript on file in the Senate, and as printed by the State Department, having no comma or other point in it except after the word 'patented.'

It "accords, too, with what is well understood to be the fact, that assignees and grantees usually constitute two distinct classes of purchasers, the former being those who buy a part or all of the patent right itself, and can protect their interests by suits in their own name, and the latter being those who buy only 'the right to use the thing patented,' and generally, except where the use is exclusive, (14th section,) cannot institute suits in their own name for encroachments upon it. In the face of this, to hold that assignees and grantees mean the same thing here, and that the words 'of the right to use the thing patented' apply equally to both, is a departure from the above established usage in employing those terms, and gives a different meaning to them from what is previously twice given in this very act.

"Thus in the 11th section an 'assignment' is mentioned as one thing, and

'a grant and conveyance of the exclusive right,' &c., as another; and in the 14th section 'assigns' are spoken of as if one class, and 'grantees of the exclusive right,' &c., as if another. And why does the conclusion to this clause say 'to the extent of their respective interests therein,' if such assignees and grantees, as to patents, were not in this very clause considered by Congress as having different interests, and that these were to be protected according to their respective extents? It would have said, and must be made to say, if sustaining the construction of the court, 'to the extent of that right,' or 'to the extent of that interest,' and there stop. Manifestly, then, there is not conferred on these two classes by this clause, either in its spirit or in *totidem verbis*, merely 'the right to use the thing patented,' but, on the contrary, the benefit of the renewal 'to the extent of (*706) their respective interests in the thing patented.' The interests of the grantees may be limited to the use, and those of the assignees may not be, but include the right to make and vend as well as use. Yet large or long as may be the interests of either, the benefit of the renewal is to cover them if the extent of them, under the original assignment or grant, reached to the new term. One is not to have the whole of his interests protected, and the other a part only, when their equities are the same.

"But the assignee is to have to the extent of his, which is to make, vend, and use, and the grantee only 'of the right to use' is to have the extent of his."

In the case of Blanchard and Eldridge, (Wallace, 337,) when the question arose as to the legal effect of a deed conveying certain privileges under a patent, Mr Justice Grier gives the same construction of the statute as was insisted upon by Judge Ingersoll. He says, "But the act of Congress of 1836 has regulated the assignment of patents. The 11th section provides that a patent shall be assignable, 1st, as to the whole interest; 2d, as
42 to any undivided part thereof; and 3d, an exclusive right may be granted throughout any specified part or portion of the United States.

"The 14th section requires the action for an infringement of the patent to be brought 'in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.' The word 'assignees' in this section must be construed by reference to the 11th section, already referred to, which defines in what way a patent may be assigned, to wit: either the whole, or any undivided portion of the whole."

The opinions of the eminent judges above quoted establish, by a weight of judicial authority which no Commissioner of Patents can be justified in disregarding, that although the terms "assignment" and "grant and conveyance" may be often used in legislative enactments as convertible terms, the statute of 1836 clearly intended that in the construction of its provisions the one should not be substituted for the other. It is said that upon the well-settled rule that statutes *pari materia* passed by the same legislative body are to be construed together, the use of the term assignees, as applied to the holder of sectional interests in the statute of 1837, shows the intention of the legislature in the act of 1836 to have been that the words grantee and assignee are synonymous.

The 7th section of the statute of 1837 gives the right of disclaimer to a "patentee, his administrators, executors, and assigns, whether of the whole or a sectional interest therein." The answer to this position is obvious. The statute of 1837, evidently drawn by different hands from those which framed the act of 1836, uses the term assigns and assignment in a large sense, or rather generically, while the act of 1836 uses the term strictly, or specifically. The statute of 1837 recognizes distinctly the existence of two species of the genus assignment, viz., the assignment of the whole, or the

assignment proper, under the statute of 1836, and the assignment of a sectional interest, or the grant and conveyance of the exclusive right under a patent to make and use, &c., throughout any specified part or portion of the United States.

If the legislature had understood the grantee to have been obviously synonymous with assignee, what occasion would there have been to add anything to the word assigns? That term in itself would have comprehended the transfer of the whole interests and sectional interests; but by adding the words "whether of the whole or sectional interest," they indicate the opinion that the holder of sectional interests would not be included without specific mention, and thus distinctly recognize the distinction between the assignees of the whole and the grantees of an exclusive sectional interest under the term assigns. When the statute of 1836 says, as it does in effect, "the terms assignment and grant have in law a precise meaning, and are used throughout all provisions of statute in their strict sense," I cannot conceive that the statute can be controlled or interpreted by another, which says as emphatically that it uses the term assigns not in a strict, but in a general sense.

43 It must be obvious that the inaccurate or rather loose use by the legislature as well as the courts of the popular and generic term assignment, instead of the strict term grant, furnishes no sound argument for confounding them together. The distinction between the term assignment when applied generically to any transfer of property, and the same term when used specifically as a transfer of the whole interest possessed by the assignor, is as well defined as that of the term "man" when applied to the race, and the same term applied to the sex. The occasion upon which the terms are used must determine whether they are to be understood in a broad or limited sense.

Where the word assignees is used in the 2d and 3d sections of the act of 1837, and in the 6th section of the act of 1842, it is clear from the occasions and the contexts that the term is used in a broad sense, and includes grantees. It is equally obvious that term is used generically by Chief Justice Taney, in delivering the opinion of the court in the case of Gaylord *vs.* Wilder, (10 How, 494,) when he says, "By the 14th section (of the act of 1836) the patentee may assign his entire right within and throughout a specified part of the United States, and upon such an assignment the assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee had in the territory specified, excluding the patentee himself, as well as others. Any assignment short of this is a mere license."

It will be observed that in the last sentence the license is spoken of as a species of assignment. This it could not be unless the word assignment is used in its broadest sense, for the law recognizes a marked distinction between strict assignments, grants, and licenses, the two former being required to be recorded, while the latter is not.

I cannot perceive the cogency of the argument that Congress, by the act of 1837, having clearly extended to a grantee of an exclusive sectional interest the right of disclaimer, there is no conceivable reason why the grantee of an exclusive sectional interest should not have conferred upon him the right of surrender and reissue. A sufficient reason must be presumed, as Congress has not in express terms conferred upon grantees the latter right. But I can see an obvious reason why the legislature should enlarge the rights of the public in an invention, by giving to grantees the right of disclaimer, while it might well hesitate, by conferring more extensively than it has done the right of reissue, to enlarge the rights of an

invention held by grantees, whereby the public right is diminished; for it is a matter of observation, from experience in the office, that applications for reissue are usually made for the purpose of securing more than was claimed in the original patent; the narrowing of the claim being secured by the cheaper remedy of disclaimer.

There is another objection to the reissue of a patent to the grantee of an exclusive sectional interest, besides the want of specific authority in the statute to make such reissue, which to my mind is conclusive. It is
44 that each of the grantees of exclusive sectional interests cannot, from the nature of the case, comply with the indispensable condition of a reissue, which is the surrender of the old patent. The grantee of the sectional interest of one State, while the interests for all the other States are held by the original patentee, certainly cannot surrender the old patent.

But the law says, "It shall be lawful for the Commissioner, upon the surrender to him of such patent, so to cause a new patent to be issued." It is said that the literal surrender of the original patent—that is, of the parchment or paper upon which it was written—is not an essential prerequisite of reissue. I cannot doubt that it is the intention of the statute that there should be a literal surrender of the patent itself, except in case of the loss of the instrument, when the surrender of a certified copy of the patent is admissible. The terms of the law require the surrender to be a personal act. The surrender must be made to the Commissioner, upon the surrender to him, that the patent should be actually in his hands for cancellation. Nothing less than this would seem to be requisite to carry out what the Supreme Court has declared to be the effect of a surrender, viz: "An act which, in the judgment of law, extinguishes the patent," and is "a legal cancellation of it."

This view is alone consistent with the peculiar nature of a patent. The rights of a patentee are not derived from the records of certain proceedings in the Patent Office, as in the case of titles founded upon judgments of courts, where the original records are kept in the custody of the court.

By the English law, from which our patent system is derived, letters patent—that is, open letters, *literæ patentes*, so called because they are not sealed up, but exposed to open view, with the great seal pendant at the bottom—or, in common parlance, patents, are held to be an open record under the great seal, containing a grant of privilege in an invention made by the crown to the inventor." (Hindmarsh's Treatise on the Law relating to Patent Privileges, 37.)

According to the same author, "the making of letters patent by the lord chancellor, by affixing the great seal to them, is an act of the court of chancery, by which the court makes a record of the Queen's grant; that is, makes her letters patent, containing her grant in pursuance of her command." (P. 37.) The most solemn sanction is given by the great seal, for it is laid down "that all the King's subjects are bound to take notice of the King's great seal, and therefore it is that the great seal shall always be credited, and can never be denied." (Hindmarsh.)

Under our first patent law, that of 1700, patents for inventions were invested with all the solemnities which comported with our institutions. They bore *teste* by the President of the United States and the "great seal" (as styled in the statute) of the United States, and the letters patent were made *prima facie* evidence in all actions brought by patentees. The substitution of the *teste* of the Secretary of the Interior, and the seal of the Patent Office, were changes for mere convenience, and do not change the effect of the letters patent. In view of the importance given to letters patent
45 by the theory of the patent law, I conceive that the statute regarded the literal letters patent as the substantial thing to be surrendered, as a prerequisite to a reissue.

Finally, the argument from inconvenience, which is admitted to be of the greatest weight in law in the interpretation of equivocal expressions, is peculiarly applicable in the determination of the question in issue. If the right of reissue to the grantees of territorial interests is admitted, there can be no limitation on account of the number of grantees or the narrow extent of the interest represented. There may be a reissue for every State and every county or town in the United States, and as many different letters patent in actual possession of different parties for the same original invention. Such a state of things could not fail to work public injury by confusing the public mind as to the actual rights held under the different patents, and would lead to inextricable confusion and perplexity in the office in tracing the titles to inventions. It seems nothing less than preposterous to conclude that the legislature intended an interpretation which would lead to such results. On the contrary, no inconvenience has been found to result or is likely to follow from the rule or construction so long adopted by the office, that the right of surrender is limited to the assignees of the whole interest.

While the advantages of turning from the beaten track are merely possible, and the perplexities of deviation are obvious, I deem it wiser to continue to tread in the ancient paths, and not to change a practice sanctioned by the wisdom of my predecessors.

D. P. HOLLOWAY, *Commissioner*.

46 SATURDAY, *June* 4, 1864.

ANDREW WHITELEY
v.
D. P. HOLLOWAY. } No. 856.—Mandamus.

This cause is argued by Mr. Clayton, for the relator, and by Mr. Hayes, for the respondent; and thereupon the court orders that it stand over for further argument.

MONDAY, *June* 6, 1864.

ANDREW WHITELEY, relator,
v.
D. P. HOLLOWAY, respondent. } No. 856.—At law.

And now again come here the parties aforesaid, by their attorneys aforesaid; whereupon, after further argument for respondent by Mr. Davidge, and a statement by Mr. Hayes, on the same side, the court declines to hear a reply from the counsel of the relator; and it is thereupon, the whole matter being fully understood, considered by the court that the relator is entitled, in law, to have his application for a reissue of the patent in question examined by the officer of the Patent Office having charge of the class of subjects to which his application belongs, or by the Commissioner himself; and it is accordingly ordered by the court that a peremptory mandamus
47 be issued commanding the respondent, Commissioner of Patents, to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law.

DISTRICT OF COLUMBIA, *to wit:*

I hereby certify that the foregoing is truly taken from the record and proceedings of the Supreme Court of the district of Columbia. In testimony whereof, I hereunto subscribe my *my* name and affix the seal of [L. S.] said court this 8th day of August, 1864.

R. J. MEIGS, *Clerk*.

Filed August 17, 1864.

Filed as an argument in the case of D. P. Holloway, Comm. of Patents by Andrew Whitely

OPINION

OF

EXAMINERS-IN-CHIEF U. S. PATENT OFFICE,

IN RELATION TO THE RIGHT OF A TERRITORIAL ASSIGNEE OF A PATENT TO APPLY FOR A RE-ISSUE.

U. S. PATENT OFFICE, *June* 19*th*, 1863.

HON. D. P. HOLLAWAY,

Commissioner of Patents:

SIR:—In the case of Andrew Whitely's application for re-issue of letters patent, referred to the Board of Examiners-in-Chief for an opinion upon the question of Whitely's right to apply for a re-issue, we have the honor to submit the following report:—

The material facts in the case appear to be as follows:

The original patent, now sought to be re-issued, was granted to Jonathan Haines, of Tazewell county, Illinois, September 4th, 1855, for improvements in mowing machines, and was numbered 13,523. Subsequently, said original letters patent were surrendered for correction and re-issue; and on the 13th of April, 1858, said surrender was accepted, and new letters patent granted, of that date, numbered re-issue 545.

On the 22d of November, 1856, the patentee sold and assigned to Ball, Aultman & Co., an exclusive right to the invention and patent within the limits of the State of Ohio.

On the 15th of January, 1860, Jonathan Haines sold and assigned to his brother, Ansel Haines, one undivided third part of his interest in the patent.

On the 25th of January, 1860, the said Jonathan and Ansel Haines sold and assigned to Isaac A. and William C. Hawley the exclusive right to the invention and patent in certain counties in Illinois, (the north half of the State.)

On the 10th of April, 1863, Ansel Haines re-assigned to Jonathan all his interest in the patent; thus re-vesting in the original patentee the entire interest in the patent, except the territorial rights sold, as aforesaid, to Ball, Aultman & Co., for the State of Ohio, and to Isaac A. and William C. Hawley, for Northern Illinois.

On the 17th of April, 1863, Jonathan Haines sold and assigned all his interest in the invention and patent (excepting the territorial rights previously disposed of as aforesaid) to Andrew Whitely, the present applicant for a re-issue.

Before filing the present application for re-issue, the said Ball, Aultman & Co. (as the applicant alleges) were requested to join in the application for re-issue, and share the benefits to be derived therefrom; but refused so to do, thereby electing to hold under the present re-issue.

Whether the said Isaac A. and William C. Hawley acquiesce in this application for re-issue or not, does not appear.

The question upon which a doubt has been raised, is, whether a grantee of any exclusive interest, less than the entire interest of the patentee, has a legal right to apply for a re-issue?

The 13th section of the act of 1836, provides that in case of the death of the patentee, "or *any assignment* by him made of the original patent," the right to surrender and take a re-issued patent (where proper grounds for a re-issue exist) "shall vest in his executors, administrators, or assignees." We understand that the uniform practice of the office has been to refuse a re-issue to any assignee or grantee owning any exclusive interest, less than the entire interest of the patentee.

This practice originated under the acts in force prior to the 4th of July, 1836, which did not authorize the assignment or transfer of exclusive territorial rights. The only provision in said acts in relation to assignments, is found in the 4th section of the act of 1793, which declares, "that it

shall be lawful for any inventor, his executor or administrator, to assign *the title and interest* in said invention at any time, and *the* assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter *stand in the place of the original inventor*, both as to *right* and responsibility, and so the assignee of assigns to any degree."

It was decided by the Supreme Court in Tyler *vs.* Tuel, (6 Cranch, 324) that a transferree of all the right, title, and interest secured by a patent, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont, was not such an assignee, within the meaning of said statute, as was authorized to maintain an action on the patent, in his own name. Under said statute, so construed, it is clear that an assignee or grantee of any less interest than the entire interest of the patentee, would not be authorized to surrender the patent, or his rights under it, and take out a re-issue. The owner of a sectional right who has no authority to maintain a suit upon the patent in his own name, does not possess, within his district, all the right, title and interest of the patentee. He is not the *legal owner* of the patent, within his district, and, therefore, cannot surrender it.

But the provisions of the act of 1836, in relation to assignments or transfers, are very different from those of the act of 1793. The 11th section of said act of 1836 provides: "That every patent shall be assignable in law, either as to the whole interest or any undivided part thereof, by any instrument in writing; which assignment, *and also every grant and conveyance of the exclusive right, under any patent, to make and use, and to grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States*, shall be recorded in the Patent Office," &c.

The 14th section of the same act gives the right to sue upon the patent, for any infringement thereof, "in the name or names of the person or persons interested, whether as pa-

tentee, assignees, or as *grantees of the exclusive right within and throughout a specified part of the United States.*"

These sections have also received a construction from the Supreme Court of the United States, and several of the inferior Courts; which construction is radically different from that given to the 4th section of the act of 1793, in Tyler *vs.* Tuel.

Chief Justice Taney, in delivering the opinion of the Court in the case of Gayler *vs.* Wilder (10 Howard, 494) says: "By the fourteenth section [of the act of 1836] the patentee may *assign* his exclusive right within and throughout a specified part of the United States, and upon such an *assignment* the *assignee* may sue, in his own name, for an infringement of his rights. But, in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee had in the territory specified,—excluding the patentee himself, as well as others. And any assignment short of this is a mere license."

It has been repeatedly decided that the assignee or grantee of an exclusive sectional right, has such an absolute title, within the territory specified, that the patentee cannot affect his rights, under the original patent, by surrendering it, without his consent, and taking out a re-issue. And so, such territorial assignee may have one claim of right, under the old patent, for one section of country, while the patentee has a different claim of right, under the re-issued patent, to the same invention, for another section of country. Woodworth *vs.* Stone, 3 Story, 750; McBurney *vs.* Goodyear, 11 Cushing, 571; Potter *vs.* Holland, Ingersoll, J. Conn., 1858.

According to these decisions the assignee or grantee of an exclusive territorial right is the *absolute legal owner* of the patent within his territory, clothed with all the rights, privileges, and powers (within said territorial limits) which were vested in the patentee himself by virtue of the patent. He may continue to hold, under the old patent, all the rights

which it vested in the patentee, notwithstanding its surrender without his consent; and he may maintain a suit at law, or in equity, in his own name, on the patent, against any one who may infringe it within his territory, *even though it be the patentee himself.*

These principles are so well settled by judicial authority that they are no longer open to discussion. The precise question, whether the assignee of a less interest than the entire right and title of the patentee can surrender and take a re-issue, has never been decided by the Courts; and it never can come before the Courts in an action to test the validity of a patent so re-issued, so long as the Patent Office adheres to the practice of refusing to entertain an application for a re-issue on behalf of such an assignee. If, however, the patentee himself, after having assigned or granted an exclusive territorial right, may surrender the patent and obtain a re-issue without the consent of the assignee or grantee of such territorial right, and without affecting the rights of said territorial grantee within his specified territory, there can be no good reason why he *should not* have the power to transfer the same privilege to another. Certainly, there is none which would not apply with equal force against the policy of allowing an assignee of the *whole interest* to surrender and take out a re-issue. If, then, such assignee of a limited but exclusive territorial right has not the same power to surrender and take a re-issue that the patentee himself would have, though possessing an equally limited territorial interest, it is not because the case does not come within the reason and spirit of the statute, but because it fails to come within its strict letter.

On this ground Judge INGERSOLL, in the case of Potter *vs.* Holland, above referred to, has expressed (*obiter dictum*) the opinion, that the grantee of any exclusive right or interest, under a patent, short of the *entire interest of the patentee,* has no authority, under the act of July 4, 1836, to surrender and take

a re-issue. This question was not involved in the case, and, therefore, the opinion pronounced thereon by the learned Judge is not clothed with judicial authority, and is only entitled to so much weight as the high source from which it emanated, and the arguments by which it is enforced, warrant us in according to it.

The learned Judge bases the opinion above referred to upon the following arguments:

"There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. They are an assignee, a grantee of an exclusive sectional right, and a licensee. An assignee is one who has transferred to him in writing the *whole interest* of the original patent, or any undivided part of such whole interest in every portion of the United States. And no one, unless he has such an interest transferred to him, is an *assignee*. A grantee is one who has transferred to him in writing the *exclusive* right under the patent, to make and use, and to grant to others to make and use, the thing patented, within and throughout some specified part or portion of the United States. Such right must be an *exclusive* sectional right, *excluding* the patentee therefrom. A licensee is one who has transferred to him in writing, or orally, a less or different interest than either the interest in the whole patent or an undivided part of such whole interest, or an exclusive sectional interest." * * *

"The terms *assignee* and *grantee* are not used in the patent law of 1836 as synonymous terms, though courts, without having their attention particularly called to the subject, have sometimes used them indiscriminately, and in their popular sense. They have, however, the separate and distinct meanings above indicated."

The learned Judge further says, that even if a grantee of an exclusive sectional interest were an assignee, it would not aid the defendant in the case then pending before him, because he "was neither an assignee nor such grantee, but a

licensee merely, having no legal rights under the patent." This shows that the question now under consideration was not presented by the facts of the case, and that the opinion expressed thereon was, therefore, mere *obiter dictum*.

It will be seen that the point of the learned Judge's argument is, that the "*grantee*" of an exclusive sectional right under a patent is not an "*assignee*," within the meaning of the act of 1836, and, therefore, cannot take rights which, by the 13th section, are in terms conferred upon "assignees" only.

Now, while it is true that neither the 11th nor the 14th section of said act of 1836, denominates, in express terms, the transferree of an exclusive sectional right as an "assignee," nor the "grant and conveyance" by which the transfer is made to him, an "assignment;" yet, if said grant and conveyance, by virtue of the statute, tranfers to him all the right, title, and interest of the patentee, within and throughout the territory specified, we cannot perceive why it does not constitute him an "assignee," in law and in fact, by whatever *name* he may be called. It is a general rule, that no one not an original party or privy to a contract can maintain an action at law thereon in his own name, unless the *legal title* has become vested in him. And any transfer of a contract which will vest in the transferree the *legal title*, so as to enable him to maintain an action at law thereon in his own name, is, in the strictest sense of the term, an "assignment." The terms "assignment" and "grant and conveyance" are often used, in legislative enactments and legal proceedings, as convertible terms. If their meaning is not, in every relation, strictly identical, there are few cases in which the one may not be substituted for the other without changing the meaning or legal effect of the language.

We concede that the act of July 4, 1836, *construed by itself*, would leave the question fairly open to discussion, whether the grantee of an exclusive sectional right is an "assignee"

within the meaning of that clause of the 13th section of the act, which specifies what classes of persons shall have the right to apply for a re-issue. But when construed (as it ought to be) in connection with subsequent statutes on the same subject, it will be found that the ground for discussion is very much narrowed. It is a settled rule of law, that statutes *in pari materia*, passed by the same legislative body, are to be construed together, as if they were parts of the same act. Now, the *same Congress* that passed the act of July 4th, 1836, only eight months thereafter (March 3d, 1837,) passed another act "in addition" thereto. It was not only passed by the *same legislative body*, but by the *same identical members*. The reasons, therefore, why these two statutes should be construed together, as one and the same act, are peculiarly strong and conclusive.

The seventh section of the act of 1837, provides: "That whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material and substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and ASSIGNS, *whether of the whole or a sectional interest therein*, may make disclaimer of such parts of the thing patented as the disclaimant shall not claim to hold by virtue of the patent or ASSIGNMENT, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office," &c. "And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be possessed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him, subsequent to the record thereof."

Here we find the same Congress which passed the act of 1836, expressly conferring upon the owners of exclusive *sec-*

tional interests, new rights, by the *name* and *description* of "ASSIGNS." Could we have a more emphatic and authoritative interpretation of the language employed in the act of 1836? It is an interpretation which cannot be disregarded, without wholly ignoring a rule of construction as familiar as household words. Judge Ingersoll asserts that Congress, in said 11th section of the act of 1836, when using the words "*grant* and *conveyance*" of an exclusive sectional right, meant something different from an "*assignment*;" and that, in the 14th section of said act, when speaking of the "*grantees* of an exclusive right within and throughout a specified part of the United States," Congress did not intend to use the word "*grantees*" as synonymous with "assignees." And yet, we find the same Congress, in an act, supplemental to the act of 1836, passed a few months later, expressly conferring new rights upon patentees and their "ASSIGNS, *whether of the whole or of a sectional interest*," in a patent. This designation of the owners of sectional interests as "*assigns*," is utterly inconsistent and irreconcilable with the hypothesis, that the words "grant and conveyance," as used in the 11th section of the act of 1836, were used in contradistinction to an "assignment," or as having any different legal effect.

This emphatic interpretation of the meaning of the words "grant and conveyance," as used in the act of 1836, does not occur merely once in the act of 1837, but several times, in different sections. The 9th section provides, that when a patent is defective because the patentee has claimed too much, the patent shall be good and valid for so much of the invention as shall be truly and *bona fide* his own, &c. And then it goes on to say, that "every such patentee, his executors, administrators, and ASSIGNS, *whether of a whole or a sectional interest therein*, shall be entitled to maintain a suit at law or in equity on such patent, for any infringement of such part of the invention or discovery as shall be truly and *bona fide* his own, as aforesaid."

Again: we find in the second and third sections of said act of 1837, the words "assignees" and "assigns" used in provisions which have always been construed to embrace, and were manifestly intended to embrace, the grantees of exclusive sectional interests. And yet these provisions can only be construed to embrace such grantees, on the ground that they come within the description of "assignees" and "assigns."

It should not be overlooked, that the right to cure a defective patent by disclaimer, as conferred by the 7th section of the act of 1837, is a mere modification of the right to cure it by surrender and re-issue, as conferred by the 13th section of the act of 1836. Under the act of 1836, a defective patent, whether the defect consisted in the claiming of too much or too little, could only be cured by a surrender and re-issue. But the 7th section of the act of 1837 provides a more simple and cheaper remedy, where the defect consists merely in claiming too much. In such case, the disclaimer of record authorized by said section, accomplishes precisely the same thing as a surrender and re-issue, under the act of 1836.—The legal effect of the two remedies is precisely the same. The original patent, after the disclaimer, has precisely the same legal effect as if it had been re-issued, with the matter disclaimed left out. Now it is wholly inconceivable that Congress intended, by the act of 1837, to give this more simple and cheap remedy, of disclaimer, to any party not entitled to pursue the more expensive remedy of surrender and re-issue, provided for in the 13th section of the act of 1836. There is no conceivable reason why the grantee of a sectional interest should have conferred upon him the right to modify his patent by one of these modes, and not by the other.

It has been urged that confusion will result from allowing an assignee of a sectional interest to surrender his rights under the original patent and take out a re-issued one, which

shall only be operative within the limits of his district; because, in such case, there will be two different patents for the same invention in force at the same time. It is a sufficient answer to this objection, that precisely the same consequences result from allowing the assignee of a sectional interest to modify the patent, to the extent of his sectional interest, by disclaimer; which, it is admitted, Congress has expressly authorized him to do. This is very clearly shown by Judge Ingersoll, in his decision above referred to. He says: "The owner of a sectional interest, however, can make a disclaimer for his sectional interest, which is to be taken as a part of the original specification, for the section owned by him, and to no greater extent. After such disclaimer, a different claim of right is secured to the disclaimant, the owner of a sectional interest, from what is purported to be secured to the patentee, the owner of the remaining interest. Different claims of right in the same invention are secured to different sectional owners; there are two specifications for the same invention, one making one claim of right to an invention for one section of country, and the other making another and different claim of right to the same invention for another section of country. In effect it makes two patents out of one, one securing a claim of right to one person, and the other securing a different claim of right to another person. *This is expressly authorized by the patent laws.*"

Precisely the same results flow, also, from the doctrine, as settled by the decisions of the Courts, (and affirmed by Judge Ingersoll in Potter *vs.* Holland,) that the patentee, after having granted one or more sectional rights, may surrender his patent and take a re-issue without the consent of such sectional grantees, and without affecting their rights under the original patent.

When it is admitted that Congress has provided for producing these effects in *two* different modes, the argument that they could not have intended that the same effects should be

produced in a *third* mode, because of any supposed inconvenience or confusion resulting therefrom, must be wholly destitute of force.

By the 6th section of the act of August 29, 1862, it is enacted: "That all patentees and *assignees* of patents, hereafter granted, are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended or offered for sale, the date of the patent; and if any person or persons, patentees or *assignees*, shall neglect to do so, he, she, or they, shall be liable to a penalty of not less than one hundred dollars," &c.

No one has ever doubted that the grantee of an exclusive sectional interest will subject himself to the penalties of this section, by neglecting to stamp or engrave the date of the patent, as therein required. And yet he can only be liable to the penalty, in virtue of being an "assignee." It would be a monstrous perversion of the rules of construction to decide, that the same conveyance will constitute a man an *assignee* for the purpose of subjecting him to *penalties* imposed upon patentees and assignees only, and yet that it will fail to constitute him an assignee for the purpose of conferring upon him the *benefits* expressly secured by law to "assignees."

An opinion appears to be prevalent, in the office, that the literal surrender of the *original patent*, that is to say, of the *parchment or paper upon which it is written*, is an essential prerequisite to a re-issue. Unless the original patent is to be totally *extinguished*, there can be no practical object in requiring its literal surrender. And that there may be a valid re-issue without a total extinguishment of the original patent, is too well settled by judicial authority to be now called in question. Such is the case whenever a patentee, who has granted sectional rights under his patent, surrenders it and obtains a re-issue without the consent or acquiescence of such sectional grantees.

Chief Justice Taney, in delivering the opinion of the Court

in Gayler *vs.* Wilder, (10 How., 493,) says: "The act of 1836 declares that every patent shall be assignable in law, and that the assignment must be in writing. But the thing to be assigned *is not the mere parchment on which the grant is written.* It is the monopoly which the grant confers, the right of property which it creates." The same remarks would be equally applicable to a surrender.

Judge Ingersoll admits that courts have sometimes used the terms "assignee" and "grantee" (in reference to the act of 1836) as synonymous terms, but thinks they have done so "without having their attention particularly called to the subject." We submit that the learned Judge himself has undertaken to draw a distinction between the meaning of these terms, as used in said act, without having had *his* attention called to the emphatic interpretation which Congress has given to its own language in subsequent acts.

Chief Justice Taney, in delivering the opinion of the Supreme Court in Gayler *vs.* Wilder, (10 How., 494, interprets the language used in the act of 1836, precisely as it is interpreted in the act of 1837. He says: "By the 14th section [of the act of 1836] the patentee may *assign* his exclusive right within and throughout a specified part of the United States, and upon such *assignment* the *assignee* may sue in his own name for an infringement of his rights."

The instances in which the courts have designated and classed the grantees of exclusive sectional interests as "assignees," and the conveyances of such interests as "assignments," are numerous. See Washburn *vs.* Gould, 3 Story, 131. Woodworth *vs.* Stone, ibid 749. Suydam *vs.* Day, 2 Blatch., 23. Bicknell *vs.* Todd, 5 McLean, 240.

Curtis, in his treatise on the Law of Patents, expressly classifies the grantees of exclusive sectional interests as "assignees," in several instances. In section 190, he says, there are "three classes or degrees of *interest by assignment*" required to be recorded, to wit: "*First,* an assignment of

the whole patent; *second*, an assignment of an undivided part of the whole patent; and *third*, a grant or conveyance of the exclusive right under the patent for any part or specified portion of the United States. *Assignments* of these several classes must be recorded in the Patent Office within three months of the execution thereof, to affect intermediate *bona fide* purchasers without notice."

Judge Kane, in the case of Smith *vs.* Mercer, (4 West. Law Jour., 51,) says: "The power to surrender a patent and take a renewal thereof is vested exclusively, by section 13 of the act of 1836, in the patentee, his executors, or administrators, their assignees, and the grantees of an exclusive right for a specified part of the United States, and there is nothing in the act restricting such right because of special or limited grants or licenses previously made."

This is in direct opposition to the opinion of Judge Ingersoll in Potter *vs.* Holland. It is true that the question now under consideration was not involved in the case before the Court. In this respect, however, the opinions of both the learned judges stand upon an equal footing.

The opinion of Judge Ingersoll in Holland *vs.* Potter is just as much in conflict with the practice heretofore prevailing in the office in relation to re-issues, as it is in conflict with the application of Mr. Whitely, now under consideration. According to the practice of the office, where a patentee has transferred *all* his interest by several sectional grants, all of such sectional grantees may join in an application for re-issue. In the case now before us, according to the practice heretofore prevailing in the office, Whitely would have a clear right to surrender and take out a re-issued patent, with the concurrence of the owners of the two sectional interests previously transferred by the patentee. Now, Judge Ingersoll bases his opinion, adverse to the right of the owner of an exclusive sectional interest to take out a re-issued patent, solely upon the ground that he is not an "*assignee*"

within the meaning of the 13th section of the act of 1836. It is perfectly manifest that this reasoning would be just as fatal against the joint application of all three of the owners of the several sectional interests, as against the separate application of Whitely. For if the grantee of one sectional right is not an "*assignee*," it follows that the grantees of three distinct sectional rights cannot be "*assignees*."

After having given the subject a most careful consideration, we unhesitatingly express the opinion, that Mr. Whitely's right to surrender and apply for a re-issue is clear and unquestionable. We therefore recommend that his present application be entertained, and disposed of in the same manner as if made by the patentee himself, in the absence of any transfer to Whitely.

J. J. COOMBS,
T. C. THEAKER,
Examiners-in-Chief.

Holloway
&
Healey

Supreme Court of the United States.

D. P. HOLLOWAY, *Com'r of Patents*,
Plaintiff in Error,
vs.
ANDREW WHITELEY,
Defendant in Error.

Error to the Supreme Court of the District of Columbia.

Supreme Court of the United States.

D. P. HOLLOWAY, *Com'r of Patents*,
Plaintiff in Error,
vs.
ANDREW WHITELEY,
Defendant in Error.

Error to the Supreme Court of the District of Columbia.

Statement and points on behalf of Plaintiff in Error.

The defendant in error is the assignee of a sectional interest in a patent granted to Jonathan Hains, on the 4th of September, 1855, for an improvement in mowing machines. He holds, by virtue of several assignments, all the territory embraced in the patent, except the State of Ohio and the northern half of the State of Illinois; and in such territory he is the assignee of all the rights of the patentee.

In May, 1863, the defendant in error applied to the Commissioner of Patents for a re-issue of the patent, according to the 13th section of the patent act of 1836.

The assignees of the State of Ohio, and of the northern half of Illinois, did not join in the application.

The Commissioner of Patents, after a laborious personal investigation of the case, decided that the applicant, not being the assignee of the whole interest in the patent, was not entitled to the re-issue asked for.

(See Record, page 4, folio 10; page 11, folio 30.)

The Supreme Court of the District of Columbia granted a peremptory mandamus, (page 22, folio 46,) "commanding "the respondant, Commissioner of Patents, to refer said ap- "plication to the proper examiner, or otherwise examine "or cause the same to be examined according to law." Awrit of error was thereupon brought by the Commissioner of Patents, to remove the proceedings to this Court.

An important question arising in the case, is whether the 13th section of the patent act of 1836, authorizing a patentee and his assigns, in certain cases, to re-issue a patent, applies to the assignee of a sectional interest only. In this question the Commissioner of Patents has no personal interest, but he is desirous that it shall be settled by this Court. Similar questions frequently arise in the Patent Office, and it is important to the public interest that the statute shall receive an authoritative construction.

It is conceded that an extension of the act to assignees of sectional interests would be very convenient to them. That the necessity of a re-issue may be as great to them as to the owner of the whole interest. Indeed, that their rights may be impaired and even lost for the want of such a power.

But there are serious objections to such a construction of the statute.

1st. It might lead to as many different patents for the same invention as the patentee should grant sectional interests in it.

2d. Upon a re-issue, the original patent must be surrendered.

In Moffatt vs. Garr, (1 Black, 273,) this Court held that "a surrender of the patent to the Commissioner in judg- "ment of law extinguishes the patent. It is a legal cancel- "lation of it; and hence can no more be a foundation for a "right after the surrender than could an act of Congress "which had been repealed." If the patent be cancelled by one assignee, how can a suit be maintained upon it by anoth-

er who has not joined in the re-issue? Or, if the sectiona assignee does not happen to possess the patent, how can he surrender it to be cancelled?

3d. The omission in the 13th section of the act to mention the grantees of sectional interests, as it does in other sections, in connection with the requirement of a surrender of the patent, would seem to imply that it was not the intention of the act to extend its provisions beyond the patentee and the assignee of the whole interest.

On the part of the plaintiff in error there are consequently two

POINTS.

First. The Commissioner of Patents decided correctly that the defendant in error was not entitled to a re-issue of the patent.

Second. If his decision was erroneous, a mandamus does not lie to correct it. The Commissioner had already done what the writ commanded him to do. Any further action, such as sending the case to an examiner, would have been useless and absurd.

ELISHA FOOTE,
Of Counsel for Plaintiff in Error.

Supreme Court of the United States.

D. P. Holloway, *Commissioner of Patents,*
Plaintiff in Error,
versus
Andrew Whiteley.

No. 259.

BRIEF FOR DEFENDANT IN ERROR.

Supreme Court of the United States.

D. P. HOLLOWAY, *Commissioner of Patents, Plaintiff in Error, versus* ANDREW WHITELEY. } No. 259.

ERROR TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

BRIEF ON BEHALF OF DEFENDANT IN ERROR.

STATEMENT OF THE CASE.

On the 4th of September, 1855, Jonathan Haines, of Tazewell county, Illinois, obtained letters patent of the United States for "Improvements in Mowing Machines."

On the 13th of April, 1858, Haines surrendered said patent and obtained a reissue thereof.

On the 22d of November, 1856, *before the reissue of* 1858, Haines sold to Ball, Aultman & Co., "all the right, title and "interest which I have in the said invention, *as secured* to me "by said letters patent, for, to, and in the State of Ohio, and "in no other place or places."

On the 15th of January, 1860, Jonathan Haines, the patentee, assigned the one undivided third of the patent to his brother, Ansel Haines.

On the 25th of January, 1860, Jonathan and Ansel Haines granted to I. A. and W. C. Hawley, the "right to make, "sell and use the 'Haines Illinois Mower' in certain counties "composing the northern half of Illinois." This deed was *a mere license*, and indisputably does not confer any interest in the *patent*.

On the 10th of April, 1863, Ansel reassigned to Jonathan Haines his whole interest in the patent, thus revesting in Jonathan, the patentee, the whole patent, *except the license* in Illinois, and the *quasi-license* in Ohio.

On the 17th of April, 1863, Jonathan Haines assigned to Andrew Whiteley, of Springfield, Ohio (relator in this case), *all his interest in the invention and patent.*

On the 20th of May, 1863, Jonathan Haines executed a further deed of the patent to Whitely, in these words: "I, "&c.. do hereby sell, assign and set over, to said Andrew "Whiteley, and his legal representatives, my aforesaid reissued "patent, and all my rights thereby secured, *for the purpose of* "*enabling the said Whiteley* and his legal representatives to "prosecute upon said reissued patent, for infringements on "the rights thereby granted; REISSUE IT, and to do and perform "every act and thing in relation thereto which I might have "done had this assignment and sale not been made."

On the 21st of May, 1863, Whiteley surrendered the original reissued patent (which Haines had assigned to him for that express purpose), and applied for a second reissue, in conformity with all the requirements of the law.

The Commissioner of Patents submitted the question of Whiteley's right to apply for a reissue to the "Examiners-in-chief," who reported that in their opinion his "right to surren-"der, and apply for a reissue, is clear and unmistakable," and recommended that his "application be entertained and disposed "of in the same manner as if made by the patentee himself in "the absence of any transfer to Whiteley." The Commissioner, however, dissented from this opinion, held that Whiteley was a mere grantee of an exclusive territorial right, and that, as the other grantees, Ball, Aultman & Co. and I. A. & W. C. Hawley, did not unite with him in the application for the reissue, he *refused to examine* Whiteley's application, or to place it upon the files of the office.

Whiteley, thereupon, tendered the fee for an allowance of an appeal to the Judges of the Supreme Court of the District of Columbia, but the Commissioner of Patents refused to allow said appeal to be taken.

Whiteley then filed his petition in the Supreme Court of the

District of Columbia for a *mandamus*, commanding the Commissioner to examine, &c., the said application. The Court issued an alternative mandamus, returnable without delay. No return having been made, though personal service of the writ was made on the day of its issue, a motion for a *peremptory mandamus* was filed May 21st, and set for hearing on the 28th. A continuance having been granted, on the application of the Commissioner, to June 4th, the motion was argued, and on June 6th the Court granted a peremptory mandamus in the following words:

"And now again come here the parties aforesaid, by their "attorneys aforesaid; whereupon, after further argument for "respondent by Mr. Davidge, and a statement by Mr. Hayes "on the same side, the Court declines to hear a reply from the "counsel of the relator; and it is, thereupon, the whole matter "being fully understood, considered by the Court that the rela- "tor is entitled, in law, to have his application for a reissue of "the patent in question examined by the officer of the Patent "Office having charge of the class of subjects to which his "application belongs, or by the Commissioner himself; and it "is accordingly ordered by the Court that a peremptory man- "damus be issued, commanding the respondent, Commissioner "of Patents, to refer said application to the proper examiner, "or otherwise examine or cause the same to be examined "according to law."

POINTS.

It is admitted that in so far as it was possible, Whiteley complied with all the forms and requirements of the law. The case, therefore, presents the general question of right applicable to many cases.

It is proposed to present to the Court four points, three of which are of general application, while one has reference to the special circumstances of this case:

I.—Has the Supreme Court of the District of Columbia jurisdiction and power to grant and enforce a "Writ of Mandamus"

commanding the Commissioner of Patents to do an act enjoined by law?

II.—Is the Commissioner of Patents commanded by law to examine, or cause to be examined, a proper and lawful application for a Reissue; and does the "Writ of Mandamus" lie to enforce that command?

III.—The grantee of an exclusive territorial interest in a patent has a legal right to apply for a Reissue.

IV.—Whiteley is not a mere grantee of an exclusive territorial right.

The first, second and third of these points have been so well discussed by Mr. Clayton, in his argument before the Court below, that, as to them, I shall do no more than reprint his brief.

I.

HAS THE SUPREME COURT OF THE DISTRICT OF COLUMBIA JURISDICTION AND POWER TO GRANT AND ENFORCE A "WRIT OF MANDAMUS" COMMANDING THE COMMISSIONER OF PATENTS TO DO AN ACT ENJOINED BY LAW?

THE "Writ of Mandamus" is a *remedial* writ, issuing out of the King's Bench, or other highest court of original jurisdiction; it commands the party to whom it is directed *to do his duty*, and summarily enforces its command by attachment; and it is the sole and appropriate remedy where the law has prescribed no specific remedy, and where justice and good government require one. It is based upon the fundamental principle, that there should be a *remedy* to enforce every *right*. Without such writ, of such general application, and of such power *in terrorem*, the frequent failures of justice would be intolerable. If there were no means of compelling the public servants to obey the public will as declared in the laws, the people would be slaves to their own servants, and arbitrary decisions would prevail over law and justice. No where in the country is there so great need of the writ of *mandamus* as in the District of Columbia, where all the great depart-

ments of the general government have their offices, and where the rights of the people are so liable to infringement. It is true that there have been but few instances in which this writ has been issued here; but does not this fact result from the decision of the Supreme Court in Kendall's case, which established the power of the Circuit Court of the District of Columbia to issue writs of *mandamus* to government officers?

Examine a few judicial decisions.

In the case of Runkel *v.* Winemiller, 4 Harris and McHenry, 449, in the General Court of Maryland, in 1779, the Court said: "The writ of *mandamus* is a prerogative writ, and "grantable where the public justice of the State is concerned; "and commands an act where otherwise justice would be ob- "structed, 3 Bac. Ab. 527. * * * The Court of King's "Bench having a superintending power over inferior courts "of jurisdiction, may, and of right ought, to interfere to sup- "ply a remedy, when the ordinary forms of proceeding are "inadequate to the attainment of justice, in matters of public "concern, 3 Bac. Ab. 529–530. The position that this Court "is invested with similar powers is generally admitted, and "the decisions have invariably conformed to it; from whence "the inference is plainly deducible, that this Court may, and "of right ought, for the sake of justice, to interfere in a sum- "mary way to supply a remedy where, for the want of a spe- "cific one, there would otherwise be a failure of justice."

In the case of Griffith *v.* Cochran, 5 Binney 103–105, a rule was granted upon Cochran, Secretary of the Land Office, "commanding him to prepare and deliver patents to Robert E. "Griffith" for certain tracts of land. The Court said: "Where "a ministerial act is to be done, and there is no other spe- "cific remedy, a *mandamus* will be granted to do the act which "is required; but where the complaint is against a person who "acts in a judicial or deliberative capacity, he may be ordered "by *mandamus* to proceed to do his duty, by deciding accord- "ing to the best of his judgment, but the Court will not direct "him in what manner to decide. This was the principle

"adopted by the Supreme Court of the United States, in the "case of United States *v.* Lawrence, [3 Dallas, 42.] and it has "been frequently recognized by this Court, particularly in the "case of The Commonwealth *v.* The Judges of the Court of "Common Pleas of Philadelphia county, 3 Binn., 272. * * * "If the Secretary had in this case refused to make any calcu- "lation, or take any step whereby the business of the appli- "cant might be dispatched, it would certainly have been our "duty to compel him by *mandamus*."

Marbury *v.* Madison, 1 Cranch, 137: This case merely decides that the Supreme Court of the United States has no power to issue *mandamus* to government officers—because it would be an unconstitutional exercise of original jurisdiction.

McIntire *v.* Wood, 7 Cranch, 504: This case decides that U. S. Circuit Courts in the States can issue *mandamus* only when necessary to the exercise of their jurisdiction. It admits, however, that the authority to issue *mandamus* to federal officers is within the scope of the judicial powers of the United States, under the Constitution, but that it has not been delegated to the Circuit Courts in the States.

McClung *v.* Silliman, 6 Wheat., 598: This case decides that *State* Courts can not issue *mandamus* to U. S. officers; and otherwise concurs with McIntire *v.* Wood, as above.

Kendall *v.* United States, 12 Peters, 524: This is the leading and decisive authority upon the question.

In their decision, the Court said: "Congress has entire con- "trol over the District [of Columbia] for every purpose of "government; and it is reasonable to suppose that, in organi- "zing a judicial department here, all judicial power necessary "for the purposes of government would be vested in the courts "of justice. The Circuit Court here is the highest Court of "original jurisdiction; and if the power to issue a *mandamus* "in a case like the present exists any where, it is vested in "that Court."

"Keeping this consideration in view, let us look at the Act "of Congress—[act of 27th Feb., 1801.] The first section de- "clares that the laws of the State of Maryland as they now "exist, shall be and continue in force in that part of the dis- "trict which was ceded by that State to the United States. "* * * It was admitted on the argument that, at the date of "this act, the common law of England was in force in Mary- "land, and of course it remained and continued in force in "this part of the District; and that the power to issue a *man-* "*damus* in a proper case, is a branch of the common law, can "not be doubted, and has been fully recognized as in practical "operation in that State, in the case of Runkel *v.* Winemiller, "4 Harris and McHenry, 448. There can be no doubt but "that, in the State of Maryland, a writ of *mandamus* might be "issued to an executive officer, commanding him to perform a "ministerial act required of him by law; and if it would lie "in that State, there can be no good reason why it should not "lie in this District in analogous cases. * * * * The third "section, [of the above named Act] so far as it relates to the "present inquiry, declares: 'That there shall be a court in this "'District, which shall be called the Circuit Court of the Dis- "'trict of Columbia; and the said Court, and the judges "'thereof, shall have all the powers by law vested in the Cir- "'cuit Courts and the judges of the Circuit Courts of the "'United States.' And the fifth section declares: 'That the "'said Court shall have cognizance of all cases, in law and "'equity, between parties, both or either of which shall be "'resident or be found within the District.' * * * * * * * "We are then to construe this third section of the Act of 27th "February, 1801, as if the eleventh section of the Act of the "13th of February, 1801, had been incorporated at full length; "and by this Act it is declared, that the Circuit Courts shall "have cognizance of *all cases*, in law or equity, arising under "the Constitution and laws of the United States, and treaties "made, or which shall be made, under their authority; and "which is, of course, a delegation of the whole judicial power, "in cases arising under the Constitution and laws, &c.; which "meets and supplies the precise want of delegation of power "which prevented the exercise of jurisdiction in the cases of

"McIntire *v.* Wood, 1 Cranch, 504, and McClung *v.* Silliman, "6 Wheat., 598; and must, on the principles which governed "the decision of the Court in those cases, be sufficient to vest "the power in the Circuit Court of this District."

Decatur *v.* Paulding, 14 Peters, 515: In this case, Ch. J. Taney, in delivering the opinion of the Court, said: "In the "case of Kendall *v.* United States, 12 Peters, 524, it was de- "cided in this Court, that *the Circuit Court for Washington "county, in the District of Columbia, has the power to issue a* man- "damus *to an officer of the Federal Government* commanding "him to do a ministerial act. * * * The doctrine which "this Court now holds in relation to the executive depart- "ments of the government are the same that were distinctly "announced in the case of Kendall *v.* United States," &c.

The act of Congress of 3d March, 1863, which established the Supreme Court of the District of Columbia, in section third, says: "The Supreme Court organized by this act shall "possess the same powers and exercise the same jurisdiction "as is now possessed and exercised by the Circuit Court of the "District of Columbia," &c. 12 Stat., 762.

It has thus been demonstrated, that *this Court has the power to issue the writ of mandamus to the Commissioner of Patents whenever he shall refuse to do an act enjoined by law.*

II.

IS THE COMMISSIONER OF PATENTS COMMANDED BY LAW TO EXAMINE, OR CAUSE TO BE EXAMINED, A PROPER AND LAWFUL APPLICATION FOR A REISSUE; AND DOES THE "WRIT OF MANDAMUS" LIE TO ENFORCE THAT COMMAND?

The relator holds, that the law expressly commands the Commissioner to make, or cause to be made, an examination of the application; and that *mandamus* lies to enforce the examination as a legal duty, but not to specify the manner or result of the examination. That when an application for a

reissue is made in due form of law, it is the duty of the Commissioner to examine it, and take such action upon the case as will enable the applicant to appeal from his decision if it be unfavorable. To this the Commissioner objects, that the relator is not entitled to apply for a reissue, because he does not own the entire patent; that the legal question involved is *preliminary*, and determinable by him alone, without appeal; and refuses to put the case upon the files of the Patent-Office in such form, that his refusal to grant the reissue, would give the applicant an appeal to a Justice of the Supreme Court of the District of Columbia. And the object in praying for the writ was, that the Commissioner might be compelled to "examine" this case. Before the examination can be made, the case must be duly *filed*, and then, if the Commissioner refuses the patent, for any reason, we are entitled to an appeal; but as long as the Commissioner keeps us *completely out of the Patent-Office*, we are subject to his absolute will, which arbitrarily deprives us of the right of appeal.

The 13th section of act of 1836, which establishes the "reissue," provides that "*It shall be lawful* for the Commis-"sioner, upon the surrender, &c., to cause a new patent to be "issued," &c.

The 8th section of act of 1837, which is supplemental to the 13th section of the act of 1836, provides that, "Whenever such "patent shall be returned for correction and reissue, the speci-"fication of claim annexed to every such patent shall be sub-"ject to revision and restriction in the same manner as are "original applications for patents. And in all such cases the "applicant, if dissatisfied with such decision, shall have the "same remedy, and be entitled to the benefit of the same "privileges and proceedings as are provided by law in the case "of original applications for patents."

The seventh section of act of 1836 is the section which prescribes the duties of the Commissioner in regard to original applications, as referred to in the last above quoted section. It provides: "That on the filing of any such application, de-"scription and specification, and the payment of the duty

"hereinafter provided, the Commissioner *shall* make, or cause "to be made, an *examination* of the alleged new invention or "discovery;" and if it be new and useful, etc., "it *shall be his* "*duty* to issue a patent therefor"—and if not new and useful, etc., "he shall notify the applicant thereof, giving him briefly "such information and references as may be useful in judging "of the propriety of renewing his application," &c.

These three clear and co-active sections of the law most unequivocally *command* the Commissioner to *make*, &c., an *examination*.

And first—The 13th section, 1836, says: "*It shall be lawful* "for the Commissioner, &c., to issue a new patent," which *issuing* must necessarily be preceded by an *examination*. Concerning this very point, Judge Dunlop, of the late D. C. Circuit Court, in 1860, in *ex parte* Dyson, recorded in Book of Appeals, vol. iii, p. 375, in Record Room of the Patent-Office, says: "The words in the section, '*it shall be lawful* for the Commis-"'sioner, upon the surrender to him of such patent, &c., to "'cause a new patent to be issued,' &c., are to be construed as "*mandatory*, and to be of the same import as if the words had "been, '*it shall be the duty* of the Commissioner,' &c.; that is "to say, the true meaning is, that the *Commissioner is to have* "*no discretion*, in the case provided for in the section. When "the case provided for arises, he is *commanded* to exercise the "power, whether he thinks it just and right or not—in the "case assumed to exist in the section, he *has no discretion*. For "this principle of law I refer to the case of Mason *et al. v.* Fear-"son, 9 Howard, 294; in that case, the Supreme Court say: "'Whenever it is provided that a corporation or officer *may* "'act in a certain way, or *it shall be lawful* for them to act in "'a certain way, it may be insisted on *as a duty* for them to "'act so, if the matter, as here, is devolved on a public officer, "'and relates to the public, or third persons.'"

And second—The 8th section of 1837 relates back to the 7th section of 1836, and gives the applicant for a reissue the *same privileges and rights* as the applicant for an original patent.

And third—The 7th section of 1836, in the most clear and positive words, expressly ordains that "The Commissioner "SHALL make, or cause to be made, an *examination*."

This being the case, does the "writ of *mandamus*" lie to enforce that command?

Mr. Tapping, in his Treatise on Mandamus, says: "As to "the jurisdiction of the writ, it may be generally stated, that "it comprehends the execution of the common law, of stat- "utes, acts of parliament, or of the king's charter, in all cases "for which there exists no legal remedy. * * * * For- "merly the received idea was, that a *mandamus* would lie only "to command the performance of a ministerial duty; but "modern cases have gone much further, and it is now the "constant practice to grant the writ, to command the perform- "ance by any inferior jurisdiction or officer, of any public "duty, for which there is no specific remedy. The duty must "be a public one, though the value to the public is not scru- "pulously weighed. * * * The duty must also be imper- "ative, and not discretionary. * * It must, however, be "clearly understood, that although there may be a discretion- "ary power, yet if it be exercised with manifest injustice, the "court of B. R. is not precluded from commanding its due "exercise. * *When one is to act according to his discretion, and "he will not act, nor even consider the matter, the Court of B. R. "will, by* mandamus, *command him to put himself in motion to "do it.*"

See Tapp. on Man. pp. 64–66, and many cases there cited. "In some cases it is stated to be a principle as to the dispen- "sing the writ of *mandamus*, that it never issues to command "officers in their *judicial*, but only in their *ministerial* capaci- "ties; this, as the statement of a principle, is certainly erro- "neous, for the writ lies to command *both* judicial and minis- "terial officers. The form of it in the two cases is, however, "different in this, that when it issues to enforce the exercise "of a judicial capacity, it is general in its terms, and not spe- "cific." Ib. p. 225.

In support of these positions, we briefly cite as follows:

Rex *v.* Bishop of Litchfield, 7 Mod. 218: In this case Lord Harwicke, Ch. J., said: "There are several things considerable in this case. First—with regard to the Ordinary's "power of compelling schoolmasters to be licensed. Secondly—whether he acts judicially or ministerially in this "case. Thirdly—etc. * * * As to the *second:* If the "bishop here acts judicially, a *mandamus* lies, not to compel "him to grant a license, but only to *determine the one way or "the other;* as we often grant them to give sentence, generally, without directing them what sentence to give; so to "give judgment in inferior courts."

Rex *v.* JJ. of Kent, 14 East, 296. In this case Lord Ellenborough said: "If the justices had rejected the application in "the exercise of the discretion vested in them by the legislature, this court would not interfere; but if they had rejected "it on the ground now stated, that they had no power to grant "it, the court would interfere so far as to set the jurisdiction "of the magistrates in motion, by directing them to hear "and determine upon the application." Rule to show cause granted.

Upon the hearing for showing cause, Lord Ellenborough said: "We do not, however, by granting this *mandamus*, at "all interfere with the exercise of that discretion which the "legislature meant to confide to the justices of the peace in "sessions; we only say that they have a discretion to exercise; and therefore they must hear the application." Bayley, J., said: "We tell the justices that they have authority by "law to settle a rate of wages for the persons applying; but "we do not say that they are to exercise that authority in "this instance. Let them hear the application." Rule absolute.

Rex *v.* JJ. of North Riding, 2 B. and C., 291. In this case, Best, J., said: "If the law requires a certain thing to be done, "we may order it to be done by the party upon whom the "obligation of doing it is imposed. If he is to act according "to his discretion, and he will not act, or even consider the

"matter, we may compel him to *put himself in motion to do* "*the thing*, but we can not control his discretion."

Griffith *v.* Cochran, 5 Binn., 103–105; cited, *ante*, p. 5.

These four cases completely cover the present case, and clearly demonstrate the power of the Court below to command and compel the Commissioner of Patents "to hear the application;" "to exercise his discretion;" "to determine the one way or the other;" "to put himself in motion to do the thing;" "to proceed to do his duty," by examining, or causing to be examined, our application for a reissue, according to law.

III.

HAS THE GRANTEE OF AN EXCLUSIVE TERRITORIAL INTEREST IN A PATENT A LEGAL RIGHT TO APPLY FOR A REISSUE OF THAT PATENT?

It can not be doubted, that the design of Congress, in establishing the reissue, was to create a remedy for the cure of all defects in the original patent, arising from any cause except fraud. Under our law, a patent for an invention or discovery, is a grant to the inventor, by the government, of an exclusive right to the invention, for a term of years. It is a grant for a consideration, and that consideration is the benefit derived by the public from the inventor in consequence of the new and useful invention; a benefit enjoyed by the public, by reason of the use of the invention in their midst under the patent, and by reason of the opportunity to use the invention as public property at the expiration of the patent. The patentee makes available and useful to the public that which, but for him, they would not have had, and after enjoying it for a few years, surrenders it wholly to them; this benefit is a valuable consideration moving from him to the public, and natural justice requires that compensation therefor should move from the public to him. In the United States, the inventor originates and introduces his invention to the public, and gives them a full and exact description thereof—and in consideration of this, the public grant to him the exclusive

right to the invention for a brief term of years. Natural justice demands, that any defect in the instrument of grant given by the public, should be promptly corrected—because, the inventor has executed his part of the contract, and is entitled to like execution on the part of the public.

It was with such views that Chief Justice Marshall decided in 1832 (four years *before* the passage of the reissue law now in force), that a patentee, irrespective of any statutory provisions, was of natural right entitled to surrender a defective patent, and obtain a new patent, with the corrections necessary to fully protect the invention. See Grant *et al. v.* Raymond, 6 Peters, 218–249. In this case the Court said: "To "promote the progress of useful arts is the interest and policy "of every enlightened government. It entered into the views "of the framers of our Constitution, and the power 'to pro-"'mote the progress of science and useful arts, by securing "'for limited times to authors and inventors the exclusive "'right to their respective writings and discoveries,' is among "those expressly given to Congress. This subject was among "the first which followed the organization of our government. "It was taken up by the first Congress at its second session, "and an act was passed authorizing a patent to be issued to "the inventor of any useful art, &c., on his petition, 'granting "'to such petitioner, his heirs, administrators or assigns, for "'any term not exceeding fourteen years, the sole and exclu-"'sive right and liberty of making, using, and vending to "'others to be used, the said invention or discovery.' The "law further declares, that the patent 'shall be good and "'available to the grantee or grantees by force of this act, to "'all and every intent and purpose herein contained.' The "emendatory act of 1793 contains the same language, and it "can not be doubted that the settled purpose of the United "States has ever been, and continues to be, to confer on the "authors of useful inventions an exclusive right in their inven-"tions for the time mentioned in their patent. It is the reward "stipulated for the advantages derived by the public from the "exertions of the individual, and is intended as a stimulus to "those exertions. The laws which are passed to give effect to

"this purpose ought, we think, to be construed in the spirit in "which they have been made; and to execute the contract "fairly on the part of the United States, where the full benefit "has been actually received: if this can be done without trans- "cending the intention of the statute, or countenancing acts "which are fraudulent, or may prove mischievous. The public "yields nothing which it has not agreed to yield; it receives "all that it has contracted to receive. The full benefit of the "discovery, after its enjoyment by the discoverer for fourteen "years, is preserved; and for his exclusive enjoyment during "that time the public faith is pledged. That sense of justice "and of right, which all feel, pleads strongly against depriv- "ing the inventor of the compensation thus solemnly promised, "because he has committed an inadvertent or innocent mis- "take. If the mistake should be committed in the Depart- "ment of State, no one would say that it ought not to be cor- "rected. All would admit that a new patent, correcting the "error, and which would secure to the patentee the benefits "which the law intended to secure, ought to be issued. And "yet the act does not in terms authorize a new patent, even in "this case. *Its emendation is not founded on the words of the "law, but is indispensably necessary to the faithful execution of the "solemn promise of the United States.* Why should not the "same step be taken for the same purpose, if the mistake has "been innocently committed by the inventor himself? * * " * * The communication of the discovery to the public "has been made in pursuance of law, with the intent to exer- "cise a privilege which is the consideration paid by the public "for the future use of the machine. If, by an innocent mis- "take, the instrument designed to secure this privilege fails in "its object, the public ought not to avail itself of this mistake, "and to appropriate the discovery without paying the stipu- "lated consideration. The attempt would be disreputable in "an individual, and a court of equity might interpose to "restrain him."

These broad and enlightened views of the great judge who uttered them, have an evident bearing on this case, and exhibit the true policy of our patent laws, and the rules for their construction.

We are convinced, that upon the authority of this decision, you will give the reissue statute such an equitable construction that it shall harmonize with the general intent and policy of our patent system, as exemplified in the whole body of the patent law, and in a long course of enlightened decisions thereon.

In further support of the position that the right to correct a defective patent does not depend upon express statute, see Morris *v.* Huntington, 1 Paine, 348. This decision was made in 1824, twelve years *before* the reissue statute now in force was enacted. In this case, the patentee had obtained a patent in 1815, and afterwards, in 1822, obtained a patent for the same thing, except that in the former patent, the particular improvements were not claimed: the first patent, however, had not been surrendered. The Court said: "I see no insu- "perable objection to entering a *vacatur* of the patent of "record in the Department of State, if taken out inadvert- "ently, and by mistake. All the proceedings in that Depart- "ment, on the subject of patents, are *ex parte*, except in the "case of interfering applications. *The Department acts rather* "*ministerially than judicially*, and upon the representations of "the applicant, without entering into an examination of the "question of right; and there seems to be no good reason why, "on a like *ex parte* application, the patent may not be surren- "dered and cancelled of record, if no misconduct be imputa- "ble to the patentee in taking it out. * * * I am inclined "to think that a surrender of the prior patent might be made, "and that the Secretary of State might grant a new one, under "a statement of the circumstances, although not for the period "of fourteen years from the date of the second patent," &c.

Also, we refer to Shaw *v.* Cooper, 7 Peters, 292, Jan. term, 1833: In this case letters patent were obtained in 1822, and were surrendered and reissued in 1829. The Court said: "That the *holder* of a defective patent may surrender it to the "Department of State, and obtain a new one, which shall have "relation to the emanation of the first, was decided by this "Court at the last term, in the case of Grant and others *v.* "Raymond, 6 Peters, 220."

Particular attention should be given to the language of this last decision—"the HOLDER *of a defective patent may surrender it:*" the word "holder" is a general term, and can not be so restricted as to apply only to one who holds the *entire* interest in a patent—but is equally applicable to those who hold *any exclusively territorial* interest.

THE 13th section of Act of 1836, which first established the reissue as now granted, provides: "And in case of his [the "patentee's] death or ANY ASSIGNMENT by him made of the "original patent, a similar right shall vest in his executors, "administrators, or ASSIGNEES."

Does not this statute unequivocally grant unto *any assignee* the same right to a reissue that it grants to the patentee? Had it been the intention of Congress to restrict the remedy of reissue to the assignee of the *whole* interest, it would have been very easy to use words of limitation, or to have used the restrictive and definite article "the" instead of the distributive pronoun "any," before the word "assignment."

THE 11th section of the same act provides: "That every "patent shall be *assignable* in law, either as to the whole inter- "est or any undivided part thereof by any instrument in writ- "ing; which assignment, and also every grant and conveyance "of the exclusive right, &c., within and throughout any speci- "fied part or portion, &c., shall be recorded," &c. In order to sustain his construction, the Hon. Commissioner of Patents devotes the major part of his "reasons" or "return" to a criticism upon the terms "assignee" and "grantee," "assignment" and "grant," and contends, at great length, that these terms are not used interchangeably in the Patent Law. And that the 13th section, when it declares that the right of reissue "shall vest in his executors, administrators and *assignees*," meant that the term *assignees* should apply only to those who held the entire patent. This is very much like quibbling about the veriest *apices juris*, and hardly becomes the dignity of the question at issue. In reply to this argument, we cite from "Curtis on Patents," section 196: "Our statute seems "to assume and proceed upon the clear distinction, that *every*

"*grant which embraces the exclusive right under a patent*, either "as to a part or the whole, *is an assignment;* and it requires "such grants to be recorded. The test to be applied, therefore, "is whether the instrument vests in the grantee the exclusive "right, either for the whole country, or for a particular dis- "trict, of making and using the thing patented, and of grant- "ing that right to others. If it does so, it is an *assignment*." See Gayler *v.* Wilder, 10 Howard, 477; Brooks *v.* Byam, 2 Story, 525; also Suydam *v.* Day, 2 Blatchf., 20.

It is wholly immaterial that the Act of 1836 fails to declare that the *grantee* of an *exclusive sectional interest* is an *assignee;* for, if the instrument making the grant conveys to him the entire right of the patentee within and throughout his specified section, he *is* thereby made an assignee in law and in fact just as effectually as if it had been so expressly enacted.

And further, the 2d and 3d sections of the Act of 1837, (enacted by the same Congress that passed the Act of 1836, only eight months previous) make use of the words "assigns" and "assignees" in provisions which have always been regarded as embracing grantees of sectional interests. And in the 7th and 9th sections of the same act, there occur the phrases "*assigns* whether of the whole or a *sectional interest* therein;" thus showing most clearly that those who made the reissue law were not aware of the Commissioner's distinction.

The 4th section of Act of 1793, provides: "And the assignee "having recorded the said assignment, &c., shall thereafter "*stand in the place of the original inventor*, both as to right and "responsibility, and so the assignees of assigns to any de- "gree." This act was superseded by the 11th section of 1836, which was intended to enlarge the privileges of inventors and not to contract them. If, then, "assignees of assigns to any degree" have the *same* rights and responsibilities as patentees, upon what principle can they be denied the right of reissue?

The 14th section, Act of 1836, provides: "And such dam-

"ages [for infringement of patent] may be recovered by action "on the case, in any court of competent jurisdiction, to be "brought in the name or names of the person or persons in- "terested, whether as patentee, assignee, or as *grantee* of the "exclusive right within and throughout a *specified part* of the "United States." Here, in the plainest words, the statute gives the grantee of the exclusive right within a specified territory the *right to sue*. Now, it is evident that the *higher right to sue*, which can be based only upon an absolute legal *title*, implies and includes the *lower right to effectuate that title* by all necessary means.

THE 7th section, Act of 1837, establishes the "disclaimer," and provides: "Any such patentee, his administrators, execu- "tors, and *assigns*, whether of the whole *or a sectional interest* "therein, may make disclaimer of such parts, &c. * * * "And such disclaimer shall thereafter be taken and considered "as part of the original specification, to the extent of the in- "terest which shall be possessed in the patent or right secured "thereby by the disclaimant, and by those claiming by, or "under him, subsequent to the record thereof." This section was passed by the same Congress that passed the reissue section, and must be construed with and in interpretation of that section. This remedy of *disclaimer* is completely analogous to the remedy of *reissue*, except that the patent cured by "disclaimer" can not be broader than it was at first, while under the "reissue" the patent may be either broader or narrower, as the case may demand. This section expressly authorizes the grantee of a sectional interest to make disclaimer, and illustrates the liberal policy of the law, which confers new privileges upon patentees and their assigns. The application of the word "assigns" to the *holders of sectional interests*, in this section, interpretative of the reissue section, utterly destroys the hypothesis of the Commissioner, that the word "assignees" in the reissue section is to be construed in the narrow technical sense of the owner of the whole patent.

We submit that it is wholly immaterial what you *term* the holder or grantee of "all the right, title, and interest" under

a patent, in a territory, for he *is* an *assignee* in fact. The patent itself is a *grant*, and all conveyances under it are *grants*.

OTHER objections to the Commissioner's construction are: That it is clearly against the policy and intent of our whole patent system:

1st. Because such construction practically renders null and void the very statute authorizing reissues. For the design of Congress, in devising the "reissue," was to provide a remedy for curing all defects in the original patent; the reissue, then, is a remedial application, to be indicated whenever the defect is discovered. In general, patents are speedily divided and subdivided into numerous sectional exclusive interests; and the need of a reissue is generally suggested to some grantee by his experience in litigating upon his share of the patent. If now, after he has found that there is a fatal defect in his patent, he be denied the remedy of a reissue, he will possess a right without a remedy, and the design of Congress will be completely defeated.

2. Because such a construction practically renders null and void the very statute authorizing the subdivision of patent rights, and imposes impolitic restraints upon their alienation. No argument can be needed to sustain Blackstone when he says, [Book II, 288:] "Experience hath shown that property "best answers the purposes of civil life, especially in commer- "cial countries, when its transfer and circulation are totally "free and unrestrained." The Commissioner's construction is in strictly possible cases equivalent to a statute of entails upon personal property; for it imposes restrictions upon the alienation of patent rights, grievously detrimental, not only to their free alienation, but to their very existence. Whiteley's case is an instance in point: He owns the whole invention except for a limited grant, and because the grantee of Ohio will not join in the application, he is not only prevented from selling his property, but the property itself is virtually destroyed.

SUPPOSE the patentee grants "*all* his right," &c., in a patent for a certain specified territory—unless the grantee thereby acquires the right of reissue, he will possess a narrower right than that the grantor himself possessed, and in express terms conveyed to him—a certain valuable portion of the patent right—the right of reissue—will have lapsed or evaporated by the mere act of grant—and the 11th section above quoted, which authorizes the patentee to subdivide his *whole right* into numerous exclusive *partial rights*, will be rendered completely nugatory.

AGAIN, suppose that a patentee grants *all* his right, &c., in his patent, except for a single town—the assignee discovers a material defect in the patent—now, unless he himself can apply the remedy of reissue, the patent is worthless to him. But it may be said that the reissue can be obtained by the patentee, no matter how small his exclusive interest, and that the assignee can elect to hold under that reissue, which cures the defect. True, *if* the patentee choose to do so—but there is no way of compelling him to apply for the reissue; it rests wholly in his discretion. If this be the law, the door for fraud is opened wide—for it would then be in the power of the patentee to extort another price for a *part* of the *whole* which he had just sold, since the assignee would be obliged to comply with the terms of the patentee in order to have his patent so cured as to be of any value to him.

IT is admitted that a patentee, after assigning an exclusive sectional interest, can obtain a reissue without the consent of that assignee, and without affecting his rights; if the patentee possess such right of reissue in *his* section, why should not his assignee, who holds a deed for "all his right, title and interest," possess the same right in *his* section?

IT is admitted that the assignees of the entire interest can obtain a reissue. Suppose that the patentee assigns a narrow sectional exclusive interest to A, and afterward assigns the whole remaining interest to B; A and B are not "joint tenants," for they take by entirely different deeds; how then can

they jointly possess a *whole* right, unless they separately possess proportional *partial* rights? Upon what principle does the *mere uniting* in a petition for a reissue, for their own benefit, confer a right to that reissue?

But the Commissioner disapproves the practice of the office in granting a reissue to the patentee who retains only a fractional interest, and says, in his "reasons:" "It is true that "the statute, while giving the right of surrender and reissue "to the patentee, makes no exception in case he has granted "away a portion of his interest; hence the practice of the "office may have been justified by the strict letter of the stat-"ute. But it can not be conceived that the legislature in-"tended to give to the patentee, who had parted with all "but a mere fractional interest in the patent, the right to sur-"render, and thereby affect the interests of innocent third "parties derived from himself." Now, the idea sought to be conveyed is, that a patentee who has sold a territorial interest ought not to have a reissue, *because* the holder of that interest would be thereby affected without his consent; and Woodworth *v.* Stone, 3 Story, 720, is quoted in support. The Hon. Commissioner wholly misunderstands that case. The Court said: "I agree that it is not in the power of the patentee, by "a surrender of his patent, to affect the rights of third per-"sons to whom he has previously, by assignment, passed his "interest in the whole or part of the patent, without the con-"sent of such assignees." This does not deny the *right* to surrender, it merely declares that such surrender shall not injuriously affect those who fail or refuse to *ratify* the surrender. This construction has been given to this decision in many cases. Judge Ingersoll, in the case of Potter *v.* Holland, Ms., said: "The reports of other cases show that when this case "was before Judge Story, he knew that there were other "persons in various parts of the United States who had rights "under the original patent, and who had not joined in the "surrender, and whose rights would be affected by the sur-"render against their consent, if they should not agree to it, "provided he held the surrender good, and provided, also, they "could not hold under the old patent. When, therefore, he

"held the surrender good and valid, and decided that 'it was "'not in the power of the patentee, by a surrender of his pat-"'ent, to affect the rights of third persons, to whom he had "'previously passed his interest, in the whole or a part of the "'patent, without their consent,' he must have been of the "opinion that, notwithstanding such surrender and reissue, "such third persons could hold under the old patent if they "should so choose, for otherwise their rights would be injuri-"ously affected without their consent."

The Commissioner assumes that "the surrender of the old patent has the effect to extinguish it," and that if the patentee obtains a reissue without the grantee's consent, there is nothing in existence in which the grantee has rights, except the reissued patent, and in support of this assumption quotes Moffitt *v.* Garr, 1 Black, 273. We submit, however, that he has made an insufficient quotation, and that the case is not so utterly at variance with the general tenor of patent decisions as to sustain the Commissioner's view. The Court said: "Now the "point in the case is, whether or not the patentee may main-"tain a suit on the surrendered patent, instituted before the "surrender, if he has not availed himself of the whole of the "provision, and taken out a reissue of his patent with an "amended specification. The construction given to this sec-"tion, so far as we know, and the practice under it, in case of "a surrender and reissue, are that the pending suits fall with "the surrender. A surrender of the patent to the Commis-"sioner, within the sense of the provision, means an act which, "in judgment of law, extinguishes the patent. It is a legal "cancellation of it, and hence can no more be a foundation "for a right after the surrender, than could an act of Congress "which had been repealed. It has frequently been determined "that suits pending which rest upon an act of Congress, fall "with the repeal of it. The reissue of the patent has no con-"nection with or bearing upon antecedent suits. The antece-"dent suits depend upon the patent existing at the time they "were commenced, and unless it exists, and is in force at the "time of trial and judgment, the suit fails." Had it been the intention of the court to affirm the English doctrine, that

surrender absolutely *vacates* the patent, they would not have passed in silence over the many cases which have denied that doctrine. See the cases of Grant *v.* Raymond, 6 Peters, 220; Shaw *v.* Cooper, 7 Peters, 314; Eastman *v.* Bodfish, 1 Story, 529; Woodworth *v.* Stone, 3 Story, 753; Ames *v.* Howard, 1 Sumner, 448; Woodworth *v.* Edwards, 3 Wood and Minot, 136; and many others.

The Commissioner further says: "That each of the gran-"tees of exclusive sectional interests can not, from the nature "of the case, comply with the *indispensable* condition of a re-"issue, which is the surrender of the old patent." And contends that the actual surrender of the very *parchment* upon which the patent is written, is an essential prerequisite to a reissue. This argument can not apply to the relator, for he *has* surrendered the very parchment. It was decided in Gayler *v.* Wilder, 10 Howard, 290, that "the thing to be assigned "*is not the mere parchment upon which the patent is written.* It is "the *monopoly* which the grant confers, the right of property "which it creates." So, it is the ill-protected *monopoly* which is surrendered for a well-protected monopoly, and not the "mere parchment." It is, and long has been, the practice of the Patent-Office to reissue upon certified copies.

Finally, the Commissioner urges the argument *ab inconvenienti*, and says—if the right of territorial grantees be established—"there may be a reissue for every State, and every "county or town in the United States, and as many different "letters-patent in actual possession of different parties, for "the same original invention. Such a state of affairs could "not fail to work public injury by confusing the public mind "as to the actual rights held under the different patents, and "would lead to inextricable confusion and perplexity in the "office in tracing the titles to inventions." To one acquainted with the practice of reissues, this argument is utterly futile. For, reissues, unlike original patents, are always (nearly) procured under the advice of competent counsel, among whom there can be but little difference of opinion as to the goodness of a given "claim;" so that, if A's counsel obtains a reissue for A, and

B owns territory under the same original patent, instead of going to the delay and expense of procuring another reissue, he gets his own counsel to examine A's reissue; and finding it sufficient, elects to hold under it, and thereby makes it his own. The expected inconvenience can never occur.

IV.

WHITELEY IS NOT A MERE GRANTEE OF AN EXCLUSIVE TERRITORIAL RIGHT.

AT the time of the assignment to him, Haines had parted with no interests under the patent, except the sale to Ball, Aultman & Co., of the State of Ohio, and to I. A. and——— Hawley of some counties of Illinois. The sale of territory or the division of the franchise by territorial lines, would certainly not have been permitted unless expressly provided for by statute. Independently of positive enactment, a patentee could only assign the whole patent or an undivided portion of the whole.

The authority under which patents are subdivided, in respect to territory, is found in section 11, Act July 4, 1836, which provides: "That every patent shall be assignable in law, either "as to the whole interest, or any undivided part thereof, by "any instrument in writing; which assignment, and ALSO every "*grant and conveyance of the exclusive right under any patent*, to "make and use, and to grant to others to make and use the "thing patented *within and throughout any specified part or por-*"*tion of the United States*, shall be recorded," &c.

And in the 14th section of the same act it is provided: "That suits at law shall be brought in the name or names of "the person or persons interested, whether as patentees, as-"signees, *or as grantees of the exclusive right within and through-*"*out a specified part of the United States.*"

Here, then, we have three classes of persons in whom may be vested property in patent rights:

1. Patentees.

2. Assignees of the whole or an undivided part of the whole patent.

3. Grantees of an exclusive territorial right.

The argument of the Commissioner is, that Whiteley is a territorial grantee, and that a territorial grantee can not obtain a reissue. To this we reply:

I. A territorial grantee is an assignee, and is therefore entitled to a reissue.

II. But Whiteley is not a territorial grantee, but an assignee of the whole patent.

a. If territorial grantees are not assignees, then the franchise can never pass from the patentee by any number of territorial grants. They take *no interest in the patent*, but simply a right of use under it. The right in the patent remains in the patentee.

Such, in fact, is the decision of the Commissioner of Patents, who says, in his letter, February 22, 1864, record, page 5:

"The original patentee may surrender, no matter how small "an interest he may have retained, and the reissue affects his "interest alone."

b. But this right or interest in the patent is capable of assignment. In the language of the act just quoted, "Every "patent shall be assignable in law, either as to the whole "interest, or any undivided part thereof," &c.

If a territorial grantee is not an assignee, then the patentee still holds the "*whole interest*" in the patent.

c. When an assignment of this interest is made, the assignee succeeds to all the rights which remained in the patentee, and occupies his place for every purpose, except that of applying for an extension of the patent.

That he is entitled to apply for and obtain a reissue, is declared by the 13th section, Act of 1836, in unmistakable terms. "And in case of his (the patentee's) death, or *any assignment* "by him made of the original patent, *a similar right* shall vest "in his executors, administrators, or *assignees*."

"Under this section the power to surrender a patent and take "out a renewal thereof, is vested exclusively in the patentee, his "executors, administrators, or assigns, and there is nothing "restricting such right because of special or limited grants or "licenses previously made." Smith *v.* Mercer, 4 West. Law Jour., 52, Kane, J.; Pa., 1846.

"By this section the sole right to surrender is given, 1st, to "the patentee, if he is alive and has made no assignment of the "original patent; 2d, to the executors and administrators of "the patentee, after his decease, where there has been no such "assignment; and 3d, to the assignee, where there has been an "assignment of the original patent. The right to surrender is "given to no one else." Potter *v.* Holland, MS., Ingersoll, J., Ct., 1858.

"Where, however, there has been an assignment of an undi- "vided part of the whole patent, in such case the assignee and "patentee become joint owners, and should join in the surren- "der; and if they do not it will be invalid, unless the part "owner not joining shall ratify it." Ibid.

"A licensee has no authority to make a surrender, and one "made without his consent is valid. But such a licensee may "hold under the original or the reissued patent, as he prefers." Ibid.

"There may be a claim of right in an invention, under one "or the old patent, for one section of the country, and a differ- "ent claim of right, under the reissued patent, for the same "invention, for another section of the country." Ibid.

d. On the 20th of May, 1863, Haines executed a deed to Whiteley in these words:

"I, &c., do hereby sell, assign and set over to said Andrew "Whiteley, and his legal representatives, *my aforesaid reissued "patent*, and *all my rights thereby secured*, for the purpose of "enabling the said Whiteley and his legal representatives to "prosecute upon said reissued patent, for infringements on the "rights thereby granted; REISSUE IT, and to do and perform "every act and thing in relation to it *which I might have done* "had this assignment and sale not been made."

Haines here assigns to Whiteley "the patent," "all his rights," for the purpose of enabling Whiteley "to reissue it," and to do every thing in relation to it which the patentee might have done.

Surely, whatever virtue remained in Haines passed out of him by this paper, and became vested in Whiteley.

We say, therefore,

1. That a Territorial grantee is an assignee.

2. If he is not, then Whiteley is the first and only assignee of this patent.

The peculiar hardship in Whiteley's case, as presented in his petition to the Court below, which is strictly possible in other cases, furnishes an argument weighty enough to decide the case in his favor. Whiteley is the sole owner of the whole invention and patent, except for certain counties in Illinois, and in the State of Ohio. The Ohio manufacturers are annually making and selling some 20,000 machines infringing upon the Haines invention, nine-tenths of which number are sold and used outside of Ohio, thus most extensively infringing upon Whiteley's territory. This he does with impunity, because he knows that the patent is so defective that it can not sustain a suit; and of course, he will never unite with Whiteley in his application for a reissue to cure the defects in the patent. If the Commissioner's decision be upheld, this most grievous wrong will be perpetuated by the law.

We, therefore, respectfully submit that there was no error in the order granted by the Supreme Court of the District of Columbia.

S. S. FISHER,
Counsel for Andrew Whiteley.